89-114

No. _____

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1989

LEONARD M. FREEMAN, M.D.,

Petitioner,

—v.—

HEIDI WEISSMANN, M.D.,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

EUGENE L. GIRDEN
30 Rockefeller Plaza
New York, New York 10112

Attorney for Petitioner.

ROBERT P. LOBUE
PATTERSON, BELKNAP, WEBB & TYLER
30 Rockefeller Plaza
New York, New York 10112

Of Counsel.

QUESTIONS PRESENTED

1. Whether allowing a junior member of an established and eminent team of medical researchers to convert a continually evolving teaching syllabus from an admitted joint work to an individually owned derivative work, merely by the addition of material (some of which itself was jointly authored), would have a chilling effect on medical or other scientific collaborative research to the serious detriment of the scientific community and the public?

2. Under the circumstances set forth above, under the Copyright Act
   (a) Can the unilateral intent of one joint author to convert a joint work to a derivative work ignore the intent of the other would-be joint author, whose authorship appears substantially in the work in question, in determining whether the work is joint?

   (b) Can the existence of an "intent" that a revised version of an existing joint work not be a joint work, which is not communicated to the other author, suffice to render the revised work derivative rather than joint?

3. Whether the Court of Appeals' rejection of Fair Use, predicated on erroneous findings such as lack of good faith and no joint work, completely eviscerates the well-established principles of Fair Use to the extent of stifling the very creativity which that law is designed to foster?

4. Whether a sharply divided Court of Appeals' direct assault on the "clearly erroneous" rule, totally ignoring the bench trial Judge's comprehensive findings of fact, *inter alia*, with respect to the credibility and intent of the parties, the nature of the collaborative efforts of the parties, the lack of new material substantial enough to create a derivative work and to the analysis of Fair Use factors, has so far departed from the accepted and usual course of judicial proceedings, or so far sanctioned such a course by a lower court, as to call for an exercise of this Court's power of supervision?

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—v.—

HEIDI WEISSMANN, M.D.,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

The Petitioner, Leonard M. Freeman, M.D., respectfully prays that a Writ of Certiorari issue to review the judgment and opinion of the United States Court of Appeals for the Second Circuit, entered in the above-entitled proceeding on February 23, 1989, as well as the Order of the United States Court of Appeals for the Second Circuit denying a Petition for Rehearing, filed on April 14, 1989.

OPINIONS BELOW

The opinion of the Court of Appeals for the Second Circuit is reported at 868 F.2d 1313 (2d Cir. 1989) and is reprinted in Appendix A hereto, pp. A 1-33, *infra*.

The opinion of the United States District Court for the Southern District of New York (Pollack, D.J.) is reported at

684 F.Supp. 1248, and is reprinted in Appendix B hereto, pp. B 1-27, *infra*.

The Order of the Court of Appeals for the Second Circuit denying the Petition for Rehearing has not been reported. It is reprinted in Appendix C hereto, p. C 1, *infra*.

JURISDICTION

Invoking federal jurisdiction under 28 U.S.C. § 1338(a) and 17 U.S.C. § 501(b), the respondent brought this suit in the Southern District of New York. On May 3, 1988, the Southern District, after a bench trial, dismissed the complaint on the merits. *See*, p. B 26, *infra*.

On respondent's appeal, the Second Circuit reversed the judgment of the District Court and remanded the case with directions that judgment be entered in favor of respondent. *See*, p. A 30, *infra*.

On a Petition for Rehearing, with a suggestion for a rehearing en banc, the Second Circuit on April 14, 1989, denied the Petition for Rehearing and declined to rehear en banc. *See*, p. C 1, *infra*.

The jurisdiction of this Court to review the judgment of the Second Circuit, is invoked under 28 U.S.C. § 1254(1).

QUESTIONS PRESENTED

1. Whether allowing a junior member of an established and eminent team of medical researchers to convert a continually evolving teaching syllabus from an admitted joint work to an individually owned derivative work, merely by the addition of material (some of which itself was jointly authored), would have a chilling effect on medical or other scientific collaborative research to the serious detriment of the scientific community and the public?

2. Under the circumstances set forth above, under the Copyright Act
   (a) Can the unilateral intent of one joint author to convert a joint work to a derivative work ignore the intent of the other would-be joint author, whose authorship appears substantially in the work in question, in determining whether the work is joint?
   (b) Can the existence of an "intent" that a revised version of an existing joint work not be a joint work, which is not communicated to the other author, suffice to render the revised work derivative rather than joint?
3. Whether the Court of Appeals' rejection of Fair Use, predicated on erroneous findings such as lack of good faith and no joint work, completely eviscerates the well-established principles of Fair Use to the extent of stifling the very creativity which that law is designed to foster?
4. Whether a sharply divided Court of Appeals' direct assault on the "clearly erroneous" rule, totally ignoring the bench trial Judge's comprehensive findings of fact, *inter alia*, with respect to the credibility and intent of the parties, the nature of the collaborative efforts of the parties, the lack of new material substantial enough to create a derivative work and to the analysis of Fair Use factors, has so far departed from the accepted and usual course of judicial proceedings, or so far sanctioned such a course by a lower court, as to call for an exercise of this Court's power of supervision?

STATEMENT OF THE CASE

Respondent alleged the copyright infringement of a Nuclear Medicine refresher course syllabus (P-1), the most recent version of an evolving paper used by the parties since 1980 to accompany their continuing medical education lectures on the subject of radionuclide imaging, wherein respondent primarily sought injunctive and declaratory relief.

Following a bench trial, the District Court issued a comprehensive opinion, in which it carefully analyzed the evidence,

weighed the credibility of the parties [pp. B 16-17, *infra*], and determined that there had been no infringement, finding, *inter alia*,

> That P-1 is a joint work, of which petitioner is a joint author, written in execution of the parties' common design of research and writing with respect to an imaging agent known as "IDA" [pp. B 19-21, *infra*].
>
> That with respect to any matters newly added to P-1, petitioner was an active participant in researching and reporting [pp. B 12-14, *infra*] and that he also was the sole author of the "False-Positive Studies for Acute Cholecystits" and the preparer of the accompanying false-positive slides [pp. B 14-15, *infra*].
>
> That the parties had agreed that either of them might use P-1 for lecture purposes in both names or in the individual lecturer's name [p. B 11, *infra*], and that there was evidence of a practice that the name on the paper identified the lecturer rather than the author [pp. B 11-12, *infra*].
>
> That respondent had commenced the action not for reasons of copyright, but for personal reasons based upon employment-related grievances [p. B 18, *infra*]. Issues of credibility were also resolved in favor of petitioner and against respondent [pp. B 16-17, *infra*].
>
> That P-1 is not a derivative work, finding that its newly added matter is not sufficiently original to merit copyright protection [pp. B 21-23, *infra*], and that petitioner's contemplated use of P-1 would have been a fair use [pp. B 23-25, *infra*].

A sharply divided panel of the Second Circuit (Cardamone, J., with Pierce J., concurring in the result but disagreeing with an important aspect of the rationale) reversed in material part, remanding for entry of judgment in favor of respondent [pp. A 1-32, *infra*], while Judge Lumbard voted "to affirm the judgment of the district court in all respects, for the reasons

stated in Judge Pollack's thorough and reasoned opinion" [p. A 33, *infra*].

Judge Cardamone's view of the law as to joint authorship was a minority view, with which both Judge Pierce and Judge Lumbard disagreed. Yet, on the ground that the District Court applied the wrong legal standard [p. A 8, *infra*], the Majority opinion substituted its own findings for those made below even though none of the findings below had been adjudged clearly erroneous as required by Fed. R. Civ. P. 52(a).

The Majority opinion found that respondent terminated the parties' collaborative efforts with respect to IDA in 1984 [pp. A 13-15, *infra*] despite the reference in her 1987 vitae to two works jointly authored with petitioner as "submitted for publication" and five works with petitioner as "in preparation."

The Majority opinion ignored the compelling objective evidence of the intent of both parties that P-1 be a joint work, just as its predecessors were joint works. Disregarding this evidence of mutual intent, the touchstone of a joint work under the Copyright Act, the Majority opinion focused instead on the physical preparation of the manuscript for P-1: "as a non-contributing party to P-1, Dr. Freeman's intent . . . is not relevant to claimed joint authorship of P-1." [p. A 15] This erroneous view, from which even the concurring opinion disassociated itself, fails to recognize that P-1's minimal new matter was in substantial part the product of petitioner.

Under the majority's convolution, every up-date of the syllabus aid could have been a derivative work which either contributor could have registered surreptitiously in his or her name alone years after the fact so as to sue the other for infringement. It is only the ongoing collaborative nature of the research and authorship collaboration of petitioner and respondent that preclude such a bizarre result. But under the Second Circuit result respondent necessarily repeatedly infringed prior versions created by petitioner along the way to creating P-1! The absurdity of the result suggests the error of the logic leading to it.

Finally, the Second Circuit majority's analysis of Fair Use, predicated on erroneous findings such as lack of good faith and no joint work, completely eviscerates the well-established principles of Fair Use.

REASONS FOR GRANTING THE WRIT

I

THE SECOND CIRCUIT MAJORITY OPINION FUNDAMENTALLY MISAPPLIES THE LAW OF JOINT AUTHORSHIP BY IGNORING THE DISTRICT COURT'S UNCONTROVERTED FINDINGS REGARDING THE PARTIES' INTENTION TO CREATE A JOINT WORK

In concluding that P-1 was a joint work, the District Court pointed to overwhelming evidence that this syllabus was merely the latest update in a series that constituted a single, evolving "stock piece" upon which the parties had collaborated since April, 1980 [p. B 10, *infra*] and that the parties' course of conduct over this period led to the conclusion that petitioner and respondent had formed an agreement whereby "the stock piece could be used as a handout by either of them, in their individual or joint names, to accompany the teaching review course lecture in which the individual was the assigned lecturer" [p. B 12, *infra*]. Additionally, the District Court based the conclusion that P-1 was intended as a joint work upon the content of the work itself: aside from containing much material which had been prepared solely by petitioner, the text expressly attributes a recommendation concerning a technique for administering IDA to "we," which the District Court found was "clearly a reference to Weissmann and her collaborator" [pp. B 12-14, *infra*].

Petitioner's intent that his contributions were to an evolving joint work cannot be disregarded. Certainly, respondent could not defeat that intent without communicating the change to her long-time collaborator.

The Second Circuit majority opinion for the divided panel, failed to give the District Court's findings of fact the deference which they are due under Fed. R. Civ. P. 52(a). On the contrary, the *de novo* review of the evidence, improperly substituting selective evaluation of the facts for the express findings made after careful review by the District Court, directly contravened Rule 52(a)'s injunction that "[f]indings of fact, whether based on oral or documentary evidence, shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge the credibility of the witnesses." *See* Point IV, *infra*.

This *de novo* review resulted in a highly distorted analysis of the evidence in this case, and a wholly unfounded interpretation of its legal significance. The majority's repeated and erroneous statements that petitioner made no contribution to P-1 are strikingly refuted by the District Court's findings that P-1 consisted primarily of material jointly written by the parties for previous syllabi and other works or written individually by petitioner alone. Even the new matter in P-1 had in substantial part originated with petitioner's participation [pp. B 16-19, *infra*].

In addition to fundamentally misapprehending critical evidence in this case, the majority opinion, in effect, refashions the law of joint authorship by disregarding objective evidence of the parties' intent to create a joint work, and relying upon the self-serving, subjective and uncommunicated "intent" of one of the authors. As correctly noted in the concurring opinion, petitioner need not have "contributed to each incremental addition to the work" in order to be deemed a joint author. A view of the law that is firmly established in the Second Circuit, recognizing that contributors to a joint work need not "work in concert or even . . . know each other; it is enough that they mean their contributions to be complementary in the sense that they are to be embodied in a single work . . .". *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F.2d 266, 267 (2d Cir. 1944). Although there was ample evidence of petitioner's substantial contributions to P-1, the majority not only misapplied the law with its suggestion that the parties must work contemporaneously, but rode roughshod over the District

Court's fact findings as to the parties' intent without any of those findings having been adjudged clearly erroneous.

In order to create a joint work, authors need only have "the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole." 17 U.S.C. § 101. Rejecting the district court's findings, which had been based upon compelling, objective evidence of the parties' long-standing intent to have created an evolving joint work, the majority opinion relies instead upon its own speculative conclusion that P-1 followed a 1984 termination of this collaboration. However, any suggestion that respondent intended to sever their collaboration even as of 1985 is directly contradicted by her 1987 vitae, discussed above. In drawing this conclusion, the majority relies, in large measure, upon respondent's use of her own by-line as evidence of her intent to establish individual authorship. But this rewrites another finding of the District Court regarding the parties' long-established practice of using the syllabus with the by-line of only one of the authors [p. B 12, *infra*] with "some indication of a practice that, rather than designating the authorship, the by-line name . . . was utilized as an identification of the reviewer or lecturer who was to appear before the audience" [p. B 11, *infra*]. If the by-line alone is determinative of intent, the majority's reasoning allows the conclusion that petitioner's 1984 Harvard syllabus was an individual work, and that respondent's whole use of it at Mount Sinai later in 1984 was an infringement.

II

THE SECOND CIRCUIT FUNDAMENTALLY MISAPPLIES THE LAW REGARDING DERIVATIVE WORKS BY OVERLOOKING THE LACK OF ORIGINALITY OF RESPONDENT'S CONTRIBUTIONS TO P-1

In order to qualify for protection as a derivative work under 17 U.S.C. § 103, a work must contain "some substantial, not merely trivial originality." *L. Batlin & Son, Inc. v. Snyder*, 536

F.2d 486, 490 (2d Cir.) (*en banc*), *cert. denied*, 429 U.S. 857 (1976).

As the District Court made clear, the material added by respondent to P-1 consisted of four new references: two citing illustrations "originally prepared" by petitioner, "one citing to a work jointly authored by the parties, and one citing to a work that reported a procedure disfavored by the parties" [p. B 15, *infra*]. Moreover, the District Court found that a large portion of petitioner's individual writing on false-positives had been incorporated into P-1 [p. B 12, *infra*]. The finding that petitioner had "originally prepared" those two illustrations signifies the District Court acceptance of petitioner's testimony [pp. B 13-14, *infra*] that he had prepared all of the illustrations in P-1—a fact borne out by the permission references under all but one of the illustrations. Despite this pervasive presence of petitioner's contributions, the Majority erroneously concluded that respondent's "selection of subject matter . . . and rearrangement" constituted sufficient "originality" to qualify P-1 as a derivative work under 17 U.S.C. § 103.

The Majority's analysis is clearly mistaken. First, new matter cannot make the new version a "derivative work" rather than a joint work where the new matter is itself jointly authored. Since the false-positive studies and all illustrations were of petitioner's authorship, this in itself was a joint contribution to a pre-existing joint work and, as a matter of law and logic, the result *must* be a joint work! Further, new matter cannot make the new version a "derivative work" where the new matter is no more substantial than variations between prior versions of the work, all of which were concededly joint.

The degree of modification involved in assembling P-1 was found by the District Court to be at least as trivial as those required by the parties' previous up-dates of the stock piece [p. B 15, *infra*]. This comparative finding was not even addressed by the Second Circuit. Thus there is no basis for concluding that P-1 is any more "original" a work than any of the previous stock pieces.

More disturbingly, the Second Circuit decision could make each up-date of a continuing joint work a derivative work and enable Mr. Funk to add minimal material (some of which material was written by Mr. Wagnall) to the 47th edition of Funk & Wagnall, register the new edition solely in the name of Mr. Funk (evidencing unilateral intent to cease the age-long collaboration) and subsequently sue Mr. Wagnall for publishing the 48th edition. Such a practice would be grossly unfair and would fundamentally undermine authors' incentives to enter into such collaborative arrangements in the first place.

III

THE SECOND CIRCUIT MAJORITY'S DECISION MISCONSTRUES AND EVISCERATES THE DEFENSE OF FAIR USE

"The doctrine of fair use . . . permits courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity which that law is designed to foster." *Iowa State University Research Foundation, Inc. v. American Broadcasting Cos.*, 621 F.2d 57, 60 (2d Cir. 1980). The Second Circuit majority decision unjustifiably restricts the application of this "entirely equitable" doctrine. *Time, Inc. v. Bernard Geis Associates*, 293 F. Supp. 130, 144 (S.D.N.Y. 1968).

The Majority opinion properly acknowledges that the statutory factors for evaluating a fair use defense under 17 U.S.C. § 107 may be supplemented by considering the "underlying equities" of each case. However, its characterization of the equities of this case is grossly inaccurate. According to the Majority opinion, petitioner's use of his by-line on P-1 amounted to "appropriating another's work without crediting the author," and thus "severely undermined his right to claim the equitable defense of fair use." This indictment of petitioner is entirely unfounded given the District Court's uncontravened finding that the parties routinely attached one or the other's by-line to syllabi containing the work of both of them. [p. B 11, *infra*]. Thus, petitioner's use of his by-line was not evidence of

bad faith but only another example of the parties' established mutual practice.

Moreover, the Second Circuit Majority opinion overlooks the virtually dispositive evidence of petitioner's good faith, his immediate withdrawal of P-1 from his review course handouts upon receiving word of respondent's protest. [p. B 2, *infra*].

The Majority analysis of the four statutory "fair use" factors is at odds with the settled case law interpreting 17 U.S.C. § 107, and substantially rewrites that law. The first statutory factor requires consideration of the "purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit education purposes . . . ". The Majority's discussion of this factor overlooks the fact that Dr. Freeman's use of P-1 represented virtually a paradigmatic example of the sort of activity which the fair use doctrine was designed to protect. *See* 3 Nimmer § 13.05 at 13-72 (". . . defense of fair use will more readily be recognized where defendant's work is used for educational, scientific, or historical purposes . . .").

The Second Circuit majority opinion also distorts the significance of the non-commercial nature of petitioner's use of P-1. The Supreme Court has declared that "every commercial use of copyrighted material is presumptively an unfair exploitation. . .". *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 451 (1984). Flouting the basic purpose of the fair use doctrine, the Second Circuit majority extends the same adverse presumption to petitioner's non-commercial use. Petitioner's $250 lecture honorarium clearly was not dependent upon the submission of a hand-out).

The second statutory factor, "the nature of the copyrighted work," was initially acknowledged by the lead opinion to be favorable to petitioner because of the firmly established legal recognition of the need to disseminate factual works. This factor undoubtedly deserved greater weight in the Court's decision. Moreover, the fact that P-1 had already been published, a point entirely ignored by the majority opinion, was another aspect of the work's "nature" that should have been weighed in petitioner's favor. *Salinger v. Random House, Inc.*, 811 F.2d

90, 95 (2d Cir.), *cert. denied*, 108 S. Ct. 213 (1987). The majority opinion essentially nullifies the favorable effect of this factor by suggesting that the encouragement of factual research does not permit "wholesale appropriation of scientific works. . .". *Id.*

The unfounded suggestion that petitioner appropriated large quantities of respondent independent work also mars the discussion of the third statutory factor, "the amount and substantiality of the portion used in relation to the copyrighted work as a whole. . .". The majority opinion weighs this factor strongly against petitioner because of his use of P-1 in its entirety. Yet this approach ignores the critical fact that P-1 consisted almost entirely of preexisting material which petitioner had every right to use, as the copyright in a derivative work does not extend to "preexisting material." 17 U.S.C. § 103(b). Thus, the majority's consideration of this factor flouts the basic principle that only original material in a derivative work is protected. *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 909 (2d Cir. 1980).

The fourth statutory factor calls for consideration of "the effect of the use upon the potential market for or value of the copyrighted work." The majority opinion disregards both the clear language of the statute and case law in his discussion of this "single most important element of fair use." *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 566 (1985). Instead the Majority imports to its discussion of this factor non-economic considerations concerning the effect of petitioner's use of P-1 on respondent's reputation. Such an analysis, more appropriate to a claim of trademark infringement, clearly has no place in an evaluation of the alleged impairment of P-1's market value. As to that issue, the Second Circuit's majority opinion provides no refutation of the District Court's finding that petitioner's use of P-1 "would in all likelihood only increase the 'marketability' " of the paper. [p. B 25, *infra*]. In the absence of any such refutation, the majority evaluation of this factor fundamentally neglects the relevant factual and legal questions.

The cumulative effect of the Second Circuit majority's misapplication of each factor of the fair use doctrine is to reduce that doctrine to a nullity.

IV

THE SECOND CIRCUIT'S DIRECT ASSAULT ON THE "CLEARLY ERRONEOUS" RULE CALLS FOR AN EXERCISE OF THIS COURT'S POWERS OF SUPERVISION

Rule 17.1(a), Rules of the Supreme Court of the United States, specifies that consideration might be called for where ". . . a federal court of appeals has rendered a decision [which] has so far departed from the accepted and usual course of judicial proceedings, or so far sanctioned such a departure by a lower court, as to call for an exercise of this Court's power of supervision."

The bench trial lasted four days, during which time the District Court had the opportunity to "consider the proofs and observe the demeanor of the parties as witnesses with respect to many critical issues in controversy, including but not limited to:

1) The extent to which petitioner participated in the underlying research,

2) The extent to which petitioner had participated in the prior syllabi and other works published in the names of both parties,

3) Whether petitioner ever had himself listed as an author where he had not contributed to the work,

4) Whether respondent ever exacted from petitioner conditions upon his use of "her" work,

5) Whether petitioner had participated in the contents of P-1, and

the District Court concluded that "based upon the parties' testimony and demeanor, illumined by the documentary evidence and the testimony of non-party witnesses, the Court resolves

the issues of credibility in favor of [petitioner] and against the [respondent]." [p. B 17, *infra*].

Notwithstanding these findings of fact by the District Court, the Second Circuit Majority opinion blithely ignores the clearly erroneous standard under Fed. R. Civ. P. 52(a) without reversing a single fact determined by the District Court. The Second Circuit's rationale for so doing is ostensibly that Rule 52 is inapplicable where the district court's findings are premised on an erroneous view of legal standard, citing, *United States v. Parke, Davis & Co.*, 362 U.S. 29, 44 (1960). This is an incredible quantum leap, concluding out of the whole cloth that the District Court did not make any specific findings regarding P-1 itself and surprisingly found P-1 to be a joint work "despite [petitioner's] concession that he had no hand in P-1 preparation." The District Court specifically found that petitioner had in fact participated in the contents of P-1 and that respondent's contentions to the contrary were incredible. Accordingly, it was not the District Court that made findings of fact "predicated upon an incorrect legal standard"; it was the Second Circuit that wrongfully applied a legal standard based upon a misconception of the facts.

It is this very misapplication of Rule 52 *de novo* review that "has so far departed from the accepted and usual course of judicial proceedings" and has "so far sanctioned such a course by a lower court" so as to invoke this Court's power of supervision. Even proponents in favor of a more searching review of findings by a district court based solely on documentary evidence do not adhere to this position when the findings rest on the trial court's assessment of credibility of witnesses. There is a great public interest in maintaining the ability of a trial court to be the finder of facts. Any contrary result would undermine the powers of the district courts and foster proliferated appeals. This Court has not clearly resolved this issue (*see Bose Corp. vs. Consumers Union of the United States, Inc.*, 466 U.S. 485 (1984)), but it is respectfully submitted that this Court should resolve this issue in favor of petitioner.

V

THE SECOND CIRCUIT'S DECISION IS ERRONEOUS, REPRESENTS A GROSS MISCARRIAGE OF JUSTICE, IS UNDULY HARSH IN ITS IMPACT AND WILL HAVE A CHILLING EFFECT ON SCIENTIFIC RESEARCH

While the factors of erroneousness and harshness do not themselves require review by this Court, the gross miscarriage of justice occasioned by the Second Circuit Majority opinion will have a chilling effect on medical and other scientific collaborative research to the serious detriment of the scientific community and the public. Most important medical and other scientific discoveries have been the result of collaboration between two or more eminent practitioners in a particular scientific field. If we engender a fear that one collaborator can unilaterally usurp the efforts of another, we will be tearing down the ability of brilliant minds to work together for the benefit of mankind.

It is extremely unfortunate that this action, sounding in copyright, dangerously interferes with the very purpose of copyright: "to promote the progress of science and useful arts." U.S. Constitution, Article I, Sec. 8, Cl. 8.

CONCLUSION

For the foregoing reasons, this petition for certiorari should be granted. The United States Court of Appeals for the Second Circuit, in a fragmented one-to-one-to-one opinion has reached a wrong conclusion by applying wrong procedure to misinterpreted facts, to the detriment of the medical research community and the public.

July 13, 1989

Respectfully submitted,

EUGENE L. GIRDEN
30 Rockefeller Plaza
New York, New York 10112
Attorney for Petitioner

ROBERT P. LOBUE
PATTERSON, BELKNAP, WEBB
& TYLER
30 Rockefeller Plaza
New York, New York 10112
Of Counsel

APPENDICES

Appendix A

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

Nos. 225, 353—August Term 1988

(Argued October 20, 1988 Decided February 23, 1989)

Docket Nos. 88-7435, 88-7465

HEIDI S. WEISSMANN, M.D.,

Plaintiff-Appellant, Cross-Appellee,

—v.—

LEONARD M. FREEMAN, M.D.,

Defendant-Appellee, Cross-Appellant.

Before:

LUMBARD, CARDAMONE, and PIERCE,
Circuit Judges.

Heidi S. Weissmann, M.D., appeals from a judgment of the United States District Court for the Southern District of New York (Pollack, J.) entered on May 11, 1988, dismissing after a bench trial appellant's claims against Leonard M. Freeman, M.D., for copyright infringement.

Defendant cross-appeals from the denial of his request for attorney's fees and sanctions.

Reversed in part and affirmed in part.

Judge Pierce concurs in the result and files a separate opinion; Judge Lumbard dissents in a separate opinion.

ROGER L. ZISSU, New York, New York (Cowan, Liebowitz & Latman, New York, New York, of counsel), *for Plaintiff-Appellant.*

GUY R. FAIRSTEIN, New York, New York (Summit Robins & Feldesman, New York, New York, of counsel), *for Defendant-Appellee-Cross-Appellant.*

CARDAMONE, *Circuit Judge*:

This appeal presents the paradigm of the problems that arise when a long relationship between accomplished professor and brilliant assistant comes to an end. Together the two had researched and co-authored scholarly scientific works. When the appellant—the younger assistant—individually wrote what she considered a new work, the appellee—the mentor—believing himself a co-author of the new piece, used his assistant's work, styling it as his own, and thereby precipitated the instant litigation.

Heidi S. Weissmann, M.D. appeals the dismissal after a bench trial in the Southern District of New York (Pollack, J.), of her copyright infringement suit against Leonard M.

Freeman, M.D. Among the issues presented on appeal is the novel question of whether a medical paper derived from the parties' prior jointly authored works is itself a joint work, or whether it is a copyrightable individual derivative work, the infringement of which gives rise to a cause of action under the Copyright Act, 17 U.S.C. § 101, *et seq.* (1982 & Supp. III 1985).

FACTS

The parties are both accomplished scientists in the field of nuclear medicine. Appellant Weissmann is an Associate Professor of Radiology and Nuclear Medicine at the Albert Einstein College of Medicine (Einstein), and is an attending physician specializing in nuclear medicine at the Montefiore Medical Center (Montefiore). She has received numerous awards in the area of radionuclide imaging, and published more than 80 scholarly articles. Appellee Freeman is also a prolific author, and a noted lecturer in the fields of nuclear medicine and diagnostic radiology. He has served as President of the Society of Nuclear Medicine, and currently is a professor of Radiology and of Nuclear Medicine at Einstein, where he has taught since 1964. He is the Director of the Nuclear Medicine Service at Montefiore and Vice-Chairman of the Department of Nuclear Medicine at Einstein.

The parties' professional association began in 1977 when Dr. Weissmann was in her fourth year of residency at Montefiore and Dr. Freeman was Chief of the Division of Nuclear Medicine at that hospital. In early 1977 appellee was researching the application of the derivatives of a certain radiopharmaceutical, iminodiacetic acid (IDA). IDA is a substance labeled with a radioactive isotope that is injected into the bloodstream and, when picked up by

the liver, permits diagnosis of certain liver and biliary disorders. In the late 1970's drug manufacturers producing IDA analogs needed scientists to develop a patient data base to obtain approval of their Food and Drug Administration applications in order to market the isotopes in the United States. One selected scientist was Dr. Freeman, who began using the IDA analogs in his research efforts. As a fourth-year resident, appellant worked on these initial studies under Dr. Freeman's tutelage. The parties' first jointly authored article on IDA derivatives was published in January 1979. Over the next several years a series of articles on the use of IDA scanning in diagnosing biliary diseases were published in the names of Freeman, Weissmann, and other scientists.

Beginning in 1980 the parties worked together as researchers and co-authors of a number of papers focusing on various aspects of nuclear medicine, particularly IDA imaging. Prior versions of the work alleged to have been infringed in the instant litigation were first written in 1980 for a nuclear medicine review course sponsored by the Harvard Medical School. The district court found that the work in which appellant claims a copyright (Plaintiff's exhibit 1 or P-1) is a "syllabus," that is, a paper reviewing the state of the art of hepatobiliary imaging techniques, prepared to accompany lectures, and used by medical residents to study for specialty boards. From 1980 to 1985 prior versions of P-1 were constantly revised and updated by the parties in an ongoing cooperative effort.

In 1985 Dr. Weissmann authored the article that precipitated the present copyright suit. It was entitled "Hepatobiliary Imaging" (P-1), and reported on a relatively new diagnostic technique employing radioactive analogs of the agent IDA. The work was prepared as a chapter for the

Radiological Society of North America's book entitled "Syllabus: A Categorical Course in Nuclear Medicine," printed and published in 1985. The publication listed Dr. Weissmann as the article's sole author.

Appellant's creation admittedly was derived from previous papers jointly written by the parties during the course of their professional relationship that extended from 1977 to 1984. An examination of the relevant documents reveals that portions of P-1 were taken virtually verbatim from prior jointly authored pieces that had been presented at Einstein and at the Mount Sinai School of Medicine (Mount Sinai) in 1983 and 1984 respectively. Although P-1 appears to restate the central propositions asserted in the prior works, Weissmann's exhibits includes the following new elements: (1) a new selection of photo illustrations and associated captions; (2) references to four recent reports in the pertinent literature; (3) new textual additions; and (4) reorganization of previous material. Appellee conceded at trial that this material in P-1 was created solely by appellant.

In the summer of 1987 Dr. Freeman was invited to give a review course on nuclear medicine at Mount Sinai. He prepared P-1 to use in giving the course by deleting Dr. Weissmann's name from P-1 and replacing it with his own, and by adding three words to the title. Fifty copies of the article were made. Before the date set for the course, appellant obtained one of the copies, and through counsel requested that her revised article not be circulated, and that all those who had received copies be informed that she claimed sole authorship of it. The article was removed from the packet of course materials. Dr. Freeman delivered his lecture without the use of his version of P-1.

After this incident, Weissmann filed the instant suit alleging copyright infringement in violation of 17 U.S.C. § 501 (1982 & Supp. 1985). In her prayer for relief she sought a declaration that Freeman had committed actionable infringement, an injunction permanently restraining him from infringing, and an award of actual damages and profits. Appellant consented to the dismissal of her claim for attorney's fees because the copyright she obtained covering P-1 was not registered before the suit was commenced, and such is a statutory prerequisite to a claim for attorney's fees.

PROCEEDINGS BELOW

After a four-day bench trial, Judge Pollack in a written decision concluded that Dr. Freeman's use of P-1 did not violate the copyright law. 684 F. Supp. 1248 (S.D.N.Y. 1988). In support of its determination that Freeman had not infringed any legally cognizable rights that appellant may have had in P-1, the district court found that appellee was a joint author, and therefore a co-owner of any copyright Weissmann acquired in the article. 684 F. Supp. at 1260. The trial court also determined that P-1's new matter was too trivial to qualify for protection as a derivative work under the copyright statute. *Id.* at 1261. Additionally, it ruled that even were Freeman not a joint author of the allegedly infringed work, and even were P-1's new matter copyrightable, Freeman's purported use of P-1 was a fair use within the purview of § 107 of the Copyright Act. *Id.* at 1261-62.

In the course of the proceedings the district court denied appellant's two substantive motions. The first was pursuant to Rule 15(b) for leave to amend the pleadings to conform to the proof. Appellant sought to have the court

evaluate and consider claims arising from appellee's allegedly publishing another verbatim copy of P-1 under his name for a December 1986 symposium in the Republic of China (the Taiwan Publication), and the supposed proof that Freeman's conduct constituted misrepresentation of origin under § 43(a) of the Lanham Act and under the common law. The second motion made under Rule 60(b) sought reconsideration by the trial court of its finding that the Taiwan Publication had not been proven to be connected with Dr. Freeman. Appellee's request for attorney's fees and for sanctions was denied. Appellant appeals from the dismissal of her copyright infringement suit, and appellee cross-appeals from the denial of attorney's fees and sanctions against appellant.

DISCUSSION

On appeal appellant argues that the district court erred in (1) determining that appellee was a joint author of P-1 within the meaning of §§ 101 and 201 of the Copyright Act, (2) concluding that P-1 did not contain sufficient new matter to qualify for copyright protection as a derivative work under §§ 101 and 103(b), and (3) deciding that, even if appellee was not a joint author and the article therefore did qualify for protection as a derivative work, appellee's use of P-1 constituted a fair use under § 107, and (4) denying appellant's 15(b) and 60(b) motions.

I *Joint Authorship*

Before discussing whether P-1 was a joint work, we set forth the standard of review to be applied to the district court's determination that P-1 was such a work. Ordinarily the clearly erroneous standard under Fed. R. Civ. P.

52(a) would govern. But, when a district court makes findings of fact predicated upon an incorrect legal standard such findings are not binding on an appellate court. *See United States v. Parke, Davis & Co.*, 362 U.S. 29, 44 (1960) (Rule 52 inapplicable where district court's findings premised on erroneous view of legal standard).

Here the district court determined that the entire series of the parties' works on the subject of radionuclide imaging—including the work alleged to have been infringed—constituted a single evolutionary joint work. It discussed the conceded joint authorship in the preexisting works. Without making any specific findings respecting P-1 itself, the court found that Dr. Freeman was a co-owner of P-1 and that P-1 was a joint work. The trial court made this surprising finding despite Dr. Freeman's concession that he had no hand in P-1's preparation. The finding was made based on the district court's mistaken view that joint authorship of the prior existing works automatically makes the two joint authors co-owners of the derivative work. Such a ruling stands copyright law on its head. It flies in the face of the Copyright Act which affords protection to each work at the moment of its creation. Thus, § 101 provides for those works prepared over time that "the portion of it that has been fixed at any particular time constitutes the work as of that time, and where the work has been prepared in different versions, each version constitutes a separate work."

Of greater significance is that the trial court's view would convert all derivative works based upon jointly authored works into joint works, regardless of whether there had been any joint labor on the subsequent version. If such were the law, it would eviscerate the independent copyright protection that attaches to a derivative work

that is wholly independent of the protection afforded the preexisting work. *See* § 103(b). Hence, it was a plain error for the district court to rule, as a matter of law, that Dr. Freeman's joint authorship of the prior works made him a joint author with appellant in the derivative work.

The district court also made a finding of fact that Dr. Freeman was a joint author with Dr. Weissmann of P-1. Section 201(a) of the Act provides: "Copyright in a work protected under [the Copyright Act] vests initially in the author or co-authors of the work." Section 101 defines a "joint work" as one "prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole." In a joint work each author "automatically acquires an undivided ownership in the entire work" including any portion of it. 1 M. Nimmer, *Nimmer on Copyright* § 6.03, at 6-6 (1988). Thus, an action for infringement between joint owners will not lie because an individual cannot infringe his own copyright. The only duty joint owners have with respect to their joint work is to account for profits from its use. *See Donna v. Dodd, Mead & Co.*, 374 F. Supp. 429, 430 (S.D.N.Y. 1974).

A review of the meaning of §§ 101 and 103(b) and of their legislative history reveals two basic criteria that must be satisfied before one is a joint author of a derivative work. First, each putative author must have "contributed" to the work. Second, each must intend to contribute to a joint work at the time his or her alleged contribution is made. Because § 103(b) extends independent protection to derivative works, an intent to contribute or an actual contribution to previous works does not serve as proof of ownership in the derivative work. *See* H.R. Rep. No. 1476, 94th Cong., 2d Sess. 103, 120, *reprinted in* 1976

U.S. Code Cong. & Admin. News 5659, 5736 (*House Report*). We consider these two criteria.

A. Contribution to Derivative Work

The statute envisions that each author contribute to a joint work. "Under the [§ 101] definition a work would not be 'joint' unless its authors collaborated among themselves or unless each of the authors knew, at the time the work was being written, that his contribution would be integrated as an 'inseparable' or 'interdependent' part of a 'unitary whole.' " *Supplementary Report of the Register of Copyrights on the General Revision of the U.S. Copyright Law*: 1965 Revision Bill, 89th Cong., 1st Sess., Copyright Law Revision Part 6, at 65 (House Comm. Print 1965), *reprinted in* 1 Copyright Law Revision (1964-1965).

In enacting the definition of a joint work set forth in § 101, Congress endeavored to "make[ ] plain that copyright in a derivative work is independent of, and does not enlarge the scope of rights in, any pre-existing material incorporated in it. There [was] thus no need to spell this conclusion out in the definition of 'joint work.' " *House Report* at 120. The legislative history clearly indicates that one cannot be deemed to be a joint author without actually collaborating in the work's preparation. Critical therefore "is the intention, at the time the writing is done, that the parts be absorbed or combined into an integrated unit." *Id.* That intention must be with respect to the work in which a copyright is claimed, not with respect to the prior works from which it is derived. *See MCA, Inc. v. Wilson*, 425 F. Supp. 443, 455 (S.D.N.Y. 1976) (owner of underlying work obtains no property rights in derivative work), *aff'd*, 677 F.2d 180 (2d Cir. 1981).

In the case at hand, because Dr. Freeman conceded that he had not participated in drafting the new matter included in P-1, it follows as a logical corollary, therefore, that he acquired no interest in or right to use P-1 beyond those rights which he had as co-author in the prior joint material incorporated into P-1. Even though one co-author has the right to revise a joint work in order to create an individual derivative work, the other co-author acquires no property rights in the newly created work prepared without his involvement. *See Dynamic Solutions, Inc. v. Planning and Controls, Inc.*, 646 F. Supp. 1329, 1338-39 (S.D.N.Y. 1986) (even sole author/owner of pre-existing material contained in derivative work has no property right in new matter created for the derivative work added without his participation); *see also Weinstein v. University of Illinois*, 811 F.2d 1091, 1095 (7th Cir. 1987); *House Report* at 120; 1 Nimmer § 6.06[B], at 6-15.

B. Intent to Contribute to Derivative Work

The second point upon which inquiry is focused is Dr. Weissmann's intent. The district court made no express finding on this critical issue. It simply stated in conclusory fashion that because the parties had intended P-1's predecessors to be used jointly as a "stock piece" to accompany their review lectures, they had somehow impliedly agreed that all future works on the subject of radioactive analogs of IDA, including P-1, would also be a joint work.

In order for a work to be deemed a joint work, the parties must evince "the *intention* that their contributions be merged," § 101 (emphasis added), "at the time the writing is done," *House Report* at 120, not at some later date. *See* 1 Nimmer § 6.03, at 6-7. The law on this point is set forth in *Edward B. Marks Music Corp. v. Jerry Vogel Music*

Co., 140 F.2d 266 (2d Cir. 1944) (L. Hand, J.). There it was observed that a finding of joint authorship requires that each author intend his or her contribution, at the time that it is created, to become part of a unitary work to which another will make or already has made a contribution. Or, as Judge Hand stated it, "when both plan an undivided whole . . . , their separate interests will be as inextricably involved, as are the threads out of which they have woven the seamless fabric of the work." *Id.* at 267; *see also Shapiro, Bernstein & Co. v. Jerry Vogel Music Co.*, ("*Melancholy Baby*"), 161 F.2d 406, 409 (2d Cir. 1946), *cert. denied*, 331 U.S. 820 (1947).

Marks was a case in which one individual had written the lyrics for a song and another had written the music. Neither party knew the other, but both were aware that their individual efforts would not stand alone. In holding that the resulting song was a joint work, the critical fact was that both parties were equally aware that their individual authorship efforts would have to be combined in order to create the final integrated product—a commercially viable song. *See Marks*, 140 F.2d at 267. From this, the rule has evolved that an author who intends to create a joint work must clearly demonstrate his or her intent in that regard. Although such an intent may, as in *Marks*, be inferred from the circumstances surrounding the creation of the work, in the absence of such a showing, the work is presumed to be the product of an individual author and is the sole property of its creator. *See, e.g., Gilliam v. American Broadcasting Cos., Inc.*, 538 F.2d 14, 22 (2d Cir. 1976) (Lumbard, J.) (reservation of rights by one party inconsistent with joint authorship and work not therefore joint); *Picture Music, Inc. v. Bourne, Inc.*, 314 F. Supp. 640, 645 (S.D.N.Y. 1970) (declining to find joint authorship where a "common design to create a single work" not

shown to exist), *aff'd on other grounds*, 457 F.2d 1213 (2d Cir.), *cert. denied*, 409 U.S. 997 (1972); *cf. Community for Creative Non-Violence v. Reid*, 846 F.2d 1485, 1497 (D.C. Cir. 1988), *cert. granted*, 109 S. Ct. 362 (1988).

In the present case, Drs. Weissmann and Freeman collaborated in the preparation and publication of the works from which P-1 was derived. Yet, there is no evidence that they intended their joint product to be forever indivisible like the finite whole of the completed single song in *Marks*. The facts point to a contrary conclusion. Scientific research is a quest for new discoveries and the preexisting joint works by definition were continually evolving. Dr. Weissmann believed she had a new and better approach and decided to author her research alone. Section 103(b) of the Copyright Act gives her that right when it extends independent protection to derivative works. The joint authorship of the underlying work does not confer any property right in the new work, save those rights which the co-author (here Dr. Freeman) of the previous works retains in the material used as part of the compilation of the derivative work. The district court opinion reveals a fundamental misunderstanding of these principles. This misconception is reflected in its discussion of Dr. Weissmann's intent to merge her efforts with Dr. Freeman based only on P-1's predecessors, and not on P-1 itself.

C. Appellant's Intent to Create a Derivative Work

The remainder of discussion of joint authorship concerns the substantial and uncontroverted evidence that Dr. Weissmann intended P-1 to be her own individual work. As a preliminary matter, it is important to note that of the 88 articles, abstracts, and book chapters listed on her curriculum vitae, 71 credit Dr. Freeman as a co-author.

Appellant's having deviated from that pattern in submitting P-1 for publication as a chapter in the Radiological Society of North America's book under the name "Heidi S. Weissmann" is persuasive proof of the fact that she intended this particular piece to represent her own individual authorship. Appellant's use of her own by-line on P-1 constitutes *prima facie* proof that this work was not intended to be joint. Appellee failed to produce any evidence to rebut appellant's showing. In fact, Dr. Freeman lectured at the same meeting at which P-1 was first presented, and made no objection to the omission of his name from it.

Again, had the trial court separately considered P-1, it would have concluded that appellant's article was the only work with respect to which it was repeatedly conceded that appellee had played no role. Yet, the trial judge found that "plaintiff did almost all of the writing" for the works listed on her resume of which Freeman was a "co-author" and that she routinely "submitted drafts to Dr. Freeman before publication." 684 F. Supp. at 1254. It also found that "[s]he would always make sure to leave a copy of a manuscript on his desk if he was not in town or busy with other commitments; she did not always get comments back, but often she did." *Id.* Hence, it is significant on the issue of appellant's intent that P-1 was one of those few works that was not submitted for Dr. Freeman's review and on which she did not receive his comments. These facts—found by the district court—strongly evidence appellant's intent that P-1 be solely her own work.

The district court found that Freeman's participation in the preparation of P-1 was "strikingly illustrated" by Weissmann's inclusion in P-1 of a section entitled "False-Positive Studies for Acute Cholecystitis" which Dr. Free-

man had independently composed for a 1984 Harvard review course. The incorporation of this material into P-1 is irrelevant to the question of whether or not the parties intended P-1 to be a joint work. Appellant correctly points out that the inclusion of the "False Positive" section is not proof of any intention on Dr. Freeman's part to make a contribution to P-1 because, prior to 1985, he could not have formed an intent to contribute his efforts to her then nonexistent work.

In sum, the evidence presented at trial fully supports appellant's contention that the work alleged to have been infringed was solely the product of her authorship efforts. Although her work derived from preexisting jointly authored material, appellee played no role in P-1's creation. As a non-contributing party to P-1, Dr. Freeman's intent regarding his contributions to the underlying preexisting work is not relevant to claimed joint authorship of P-1. The district court's conclusion that P-1 was a joint work because the entire series of the parties' articles on IDA, including P-1, was one evolutionary joint work disregards the copyright protection accorded derivative works, independent of the preexisting works under § 103(b). As a consequence of its plain error of law in this regard, the district court's finding of fact that Freeman's co-authorship of the preexisting works also made him a joint author of P-1 is clearly erroneous.

II *Derivative Work*

We now turn attention to whether P-1 qualifies for protection as a derivative work as that term is defined by the Copyright Act. To establish a claim of copyright infringement, plaintiff must prove ownership of a valid copyright and copying by the defendant. With Dr. Freeman's copy-

ing admitted, the only question is whether Dr. Weissmann owned a valid copyright in a so-called derivative work. Although her certificate of registration "constitute[s] prima facie evidence of the validity of the copyright and of the facts stated in the certificate," 17 U.S.C. § 410(c), it is not conclusive on the issue of copyrightability; it merely creates a presumption of validity. *See, e.g., Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 908 (2d Cir. 1980); *Past Pluto Productions Corp. v. Dana*, 627 F. Supp. 1435, 1440 (S.D.N.Y. 1986) (certificate shifts burden to defendant to disprove copyright's validity).

Section 101 of the Copyright Act defines a "derivative work" as one that is based on "preexisting works." In addition, § 103(b) provides as follows

> The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such a work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.

Section 101 of the statute further defines a derivative work as "[a] work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship . . . ." Thus, it is clear that "the manner of expression, the author's analysis or interpretation of events, the way he structures his material and marshals facts, his choice of words, and the emphasis he gives to particular developments" are protected under the copyright laws. *Wainwright Securities,*

Inc. v. Wall Street Transcript Corp., 558 F.2d 91, 95-96 (2d Cir. 1977), *cert. denied*, 434 U.S. 1014 (1978).

The principle of derivative work protection is subject to two important limitations, both of which were purportedly recognized by the district court. To support a copyright, a derivative work must be more than trivial, and the protection afforded a derivative work must reflect the degree to which the derivative work relies on preexisting material, without diminishing the scope of the latter's copyright protection. *Durham Indus.*, 630 F.2d at 909. This rule is premised on the notion that " 'the one pervading element prerequisite to copyright protection regardless of the form of work' is the requirement of originality—that the work be the original product of the claimant." *L. Batlin & Son v. Snyder*, 536 F.2d 486, 489-90 (2d Cir.) (*en banc*) (quoting 1 Nimmer § 10, at 32 (1975)), *cert. denied*, 429 U.S. 857 (1976). Originality is and always has been rightly prized. Dostoevsky, for example, insisted that the measure of a person's worth in pre-Revolutionary Russia did not depend so much on money or position, as it did on one's originality. F. Dostoevsky, *The Idiot*, Part I (Garrett Trans. 1958). Mill wrote that "nothing was ever yet done which someone was not the first to do, and . . . all good things which exist are the fruits of originality . . . ." J.S. Mill, *On Liberty* 271 (Harv. Classics, Eliot ed. 1909).

In the law of copyright only an unmistakable dash of originality need be demonstrated, high standards of uniqueness in creativity are dispensed with. In deciding whether the originality of the matter added in P-1 is sufficient to qualify for protection as a derivative work, the standard enunciated in *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951) (Frank, J.), remains the law in this Circuit: "All that is needed to satisfy both

the Constitution and the statute is that the 'author' contributed something more than a 'merely trivial' variation, something recognizably 'his own.' " *Id.* at 102-03. The originality requirement for a revised version is a "minimal" or "modest" one. *See, e.g., Eden Toys, Inc. v. Florelee Undergarment Co.*, 697 F.2d 27, 35 (1982); *Durham Indus.*, 630 F.2d at 910; *Puddu v. Buonamici Statuary, Inc.*, 450 F.2d 401, 402 (2d Cir. 1971); *Millworth Converting Corp. v. Slifka*, 276 F.2d 443, 445 (2d Cir. 1960).

The district court here concluded that P-1 and its predecessors had evolved over an extended period of time and that Weissmann's additions were minuscule, demonstrating little originality. 684 F. Supp. at 1261. Although recognizing that the selection and arrangement of data may merit copyright protection, *see Eckes v. Card Prices Update*, 736 F.2d 859, 863 (2d Cir. 1984), the trial judge believed that "the update was done as part of the evolution of the stock piece" and that appellant's modifications of the preexisting joint works did not warrant copyright protection. 684 F. Supp. at 1261.

It was formerly our rule that where, as here, the originality of a work could be determined entirely by reference to documentary evidence, we were in as good a position as the district court to evaluate originality. *See Eden Toys*, 697 F.2d at 34 n. 6 and 35 (2d Cir. 1982); *Taylor v. Lombard*, 606 F.2d 371, 372 (2d Cir. 1979); *Jack Kahn Music Co. v. Baldwin Piano and Organ Co.*, 604 F.2d 755, 758 (2d Cir. 1979). *But see Apex Oil v. Vanguard Oil & Service Co.*, 760 F.2d 417, 424 (2d Cir. 1985) (Oakes, J. concurring) (suggesting that "appellate courts must not exercise *de novo* review over findings . . . based . . . on documents or objective evidence"). In 1985 Rule 52(a) of Fed.

R. Civ. P. was amended so that findings of fact based upon documentary—along with oral—evidence are not to be set aside unless clearly erroneous.

In our view the district court implausibly overlooked the fact that appellant's 1985 selection of subject matter and content drawn from prior works and their rearrangement in P-1 is sufficiently the product of original authorship to warrant copyright protection. It failed to give detailed consideration to the new matter that Weissmann added to the parties' prior works in her authorship of P-1. Its main discussion of P-1's content is a passing reference to the addition of "only" four new sources from the relevant scientific literature. Although the credibility of the parties as witnesses was fully discussed, the relevance of such an inquiry is problematic when the evidence upon which the derivative work determination must be based is solely documentary. Credibility might have been relevant, for example, had the question of who actually authored the new material been contested. But it is scarcely pertinent to determining whether the newly-added matter satisfies the statutory requirements for protectability. Research has not revealed a single case in which credibility has been deemed significant—let alone dispositive—on the question of whether there is a sufficient level of originality in a given work to render it copyrightable. While the district court's findings based on the credibility of witnesses is entitled to deference, the trial judge cannot insulate his findings on originality from appellate review by calling them credibility determinations. *Anderson v. City of Bessemer*, 470 U.S. 564, 575 (1985).

Our examination of the relevant documents reveals that Weissmann's additions and modifications in P-1 extend well beyond the mere addition of "four sources." A thor-

ough review of P-1 and of the works from which it is derived demonstrates that Dr. Weissmann added the following new elements to the existing prior joint work: (1) a selection and arrangement of photo illustrations and associated captions; (2) references to recent reports in the pertinent literature; (3) selection, condensation, and description of additional source material; (4) several new textual additions; (5) substantial rearrangement of the manner and order of presentation of material contained in the parties' prior joint works; and (6) the addition of a section on "congenital disorders," a revised treatment of "chronic cholecystitis," and the incorporation of Dr. Freeman's "false positive" studies.

The district court found that many of the foregoing additions and revisions repeated verbatim portions of prior works and, from that finding, concluded that P-1 was neither new nor copyrightable. This finding wholly ignores the statutory scheme that expressly protects the selection of subject matter and content from underlying works, as well as the rearrangement of preexisting material taken from those works. *See* 17 U.S.C. § 101 (defining derivative work as an "abridgment, condensation or any other form in which a work may be recast, transformed, or adapted"). Further, a comparison of the parties' prior works—including P-1's most recent predecessor—at once demonstrates numerous differences, and highlights the fact that P-1 gave IDA imaging new and original treatment. Moreover, Dr. Freeman's copying and distributing P-1 as his own work is further evidence of the nontriviality of Dr. Weissmann's work, since copying without regard to a plaintiff's rights is probative on the issue of the originality of a work. *See Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 252 (1903) (Holmes, J.) (that

works have worth is sufficiently shown by desire to copy them "without regard to the plaintiff's rights").

We conclude therefore that the district court's holding that Weissmann could not acquire a copyright in a derivative work based upon a jointly authored work was an error of law that disregarded the provisions of § 103(b) and the protection it extends to derivative works. Moreover, Dr. Freeman failed to rebut the *prima facie* showing of copyrightability appellant obtained by her certificate of copyright registration. As a consequence, we hold that Dr. Weissmann's additions and modifications to the preexisting joint work satisfy the modest requirements set forth in § 103(b) and in the relevant case law sufficiently to make P-1 entitled to copyright protection as a derivative work. The district court's findings—upon which it reached a contrary legal conclusion--were clearly erroneous because they have left us, after a thorough review of all the evidence, with a firm conviction that the district court was mistaken. *See United States v. United States Gypsum Co.*, 333 U.S. 364, 395 (1948).

III *Fair Use*

The next question to be addressed is whether Dr. Freeman's use of P-1 can be characterized as a "fair use" within the meaning of the Copyright Act, thus absolving him of liability as an infringer. Section 107 of the that Act codifies the so-called "fair use" doctrine. It creates a privilege for others to use the copyrighted material in a reasonable manner despite the lack of the owner's consent. *See Rosemont Enterprises, Inc. v. Random House, Inc.*, 366 F.2d 303, 306 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009 (1967). The doctrine balances the exclusive right of copyright owners against "the public's interest in the dissemi-

nation of information affecting areas of universal concern, such as art, science and industry." *Wainwright Securities*, 558 F.2d at 94.

The four statutory factors considered in making the fair use determination are: "(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work." 17 U.S.C. § 107. Congress established these nonexclusive factors as a guide to courts considering fair use. Determining whether the doctrine applies requires that each case be individually examined. *See Harper & Row Publishers v. Nation Enterprises*, 471 U.S. 539, 549 (1985).

Analysis begins not by elevating the statutory guides into inflexible rules, but with a review of the underlying equities. *See Financial Information, Inc. v. Moody's Investors Service, Inc.*, 751 F.2d 501, 508 (2d Cir. 1984) (fair use requires "sensitive balancing of interests," and the statutory factors are not hurdles over which an infringer may leap safely from liability). Thus, in *Sony Corporation of America v. Universal City Studios*, 464 U.S. 417, 448 (1984), the Supreme Court emphasized that the doctrine necessitates an "equitable rule of reason" analysis to determine whether an alleged infringer may shield himself from liability. *See also House Report* at 65 (stating that "since the doctrine is an equitable rule of reason, no generally applicable definition is possible, and each case raising the question must be decided on its own facts"). In short, to make use of another's copyright

material fairly presupposes that the actor acted fairly and in good faith. *See Marcus v. Rowley*, 695 F.2d 1171, 1175 (9th Cir. 1983); *see also Roy Export Co. v. Columbia Broadcasting System, Inc.*, 503 F. Supp. 1137, 1146 (S.D.N.Y. 1980) (good faith and fair dealing required), *aff'd*, 672 F.2d 1095 (2d Cir.), *cert. denied*, 459 U.S. 826 (1982).

Hence, before undertaking a discussion of fair use, we consider the equitable considerations that exist in the case at bar. In this case, it cannot be ignored that Dr. Freeman not only neglected to credit appellant for her authorship of P-1, but actually attempted to pass off the work as his own, substituting his name as author in place of hers. Adding insult to this injury, he then distributed copies of her work, but modified the title slightly to one of his own devising. Even if, as Dr. Freeman claims, P-1 was a stock piece to be used by both parties to accompany their lectures, such use hardly justifies entirely appropriating another's work without crediting the author. Dr. Freeman's conduct severely undermines his right to claim the equitable defense of fair use. No case was cited—and we found none—that sustained such defense under circumstances where copying involved total deletion of the original author's name and substitution of the copier's. *See Rowley*, 695 F.2d at 1176 (failure to credit original author weighs against a finding of fair use).

Determining fair use is a mixed question of fact and law. The Supreme Court instructs that where the district court has found facts sufficient to allow evaluation of each of the statutory factors, appellate review may determine fair use as a matter of law. *Harper & Row*, 471 U.S. at 560. With that in mind, we focus on the factors enumerated in § 107.

1. *The Purpose and Character of the Use*

In examining this factor, the district court recognized that " 'the crux of the profit/non-profit distinction is not whether the sole motive of the use is monetary gain but whether the user stands to profit from exploitation of the copyrighted material without paying the customary price.' " 684 F. Supp. at 1261 (quoting *Harper & Row*, 471 U.S. at 562). The trial judge then concluded that because Dr. Freeman received only a $250 honorarium and did not "stand to profit," the first factor cut in his favor. We think that conclusion misses the point of the above-quoted passage. Monetary gain is not the sole criterion. Dr. Freeman stood to gain recognition among his peers in the profession and authorship credit with his attempted use of Weissmann's article; he did so without paying the usual price that accompanies scientific research and writing, that is to say, by the sweat of his brow. Particularly in an academic setting, profit is ill-measured in dollars. Instead, what is valuable is recognition because it so often influences professional advancement and academic tenure. The absence of a dollars and cents profit does not inevitably lead to a finding of fair use. *See Rowley*, 695 F.2d at 1175.

Further, where, as here, appellee's use is for the same intrinsic purpose as Dr. Weissmann's, that is, as an adjunct to lectures delivered in professional symposia, such use seriously weakens a claimed fair use. *Id.*; *see also Iowa State Research Foundation, Inc. v. American Broadcasting Cos., Inc.*, 621 F.2d 57, 61 (2d Cir. 1980) (suggesting that scope of the doctrine constricted when original and copy serve the same function).

Thus, the relevant evidence bearing upon the first factor does not support invocation of the doctrine. The district

court's contrary conclusion is clearly erroneous. The trial court's statement that Freeman's use was entirely for non-profit purposes misapprehends the central proposition that the profit/non-profit distinction is context specific, not dollar dominated. Although the Supreme Court has observed that the fair use doctrine—particularly the first statutory factor—is not rigidly circumscribed by the so-called "productive use requirement," *Sony Corp.*, 464 U.S. at 455 n.40 (1984), an unproductive use "may be helpful in calibrating the balance." *Id.* Again, Dr Freeman's use of P-1 for the intrinsic purpose for which it was prepared moves the balance of the calibration on the first factor against appellee.

2. *The Nature of the Work*

With respect to the second factor, the district court, again quoting *Harper & Row*, stated that "[t]he law generally recognizes a greater need to disseminate factual works than works of fiction or fantasy." 471 U.S. at 563. From that, it found that because P-1 was a scientific work, this factor weighed heavily in appellee's favor. 684 F. Supp. at 1262.

Concededly, the scientific nature of P-1 tilts this factor toward appellee. Yet, the nature of the work is not the only matter considered. The Supreme Court instructs that "[t]he rights conferred by copyright are designed to assure contributors to the store of knowledge a fair return for their labors." *Harper & Row*, 471 U.S. at 546; *see also Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975). In *Mazer v. Stein*, 347 U.S. 201, 219 (1954) the Court explained that by establishing a right to the use of one's expression—whether in the nature of fiction or

fact—copyright provides the economic incentive to research and disseminate ideas.

Encouraging authors to use their talents by holding out a promise of reward for their efforts is the surest way to advance the public welfare. *Id.* at 219. In this case it is necessary to keep in mind the danger that allowing wholesale appropriation of scientific works presents. The personal gain sought by Dr. Weissmann may not be directly related to immediate financial gain, but the copyright protection extended to her work nevertheless provides her with an incentive to continue research—an endeavor that, if successful, would and has led to professional and monetary benefits. Hence, while recognizing that fair use finds greater application in a factual scientific context, that recognition should not blind a court to the need to uphold those incentives necessary to the creation of works such as P-1. The district court's failure to consider incentives when weighing this factor was an error of law that led to its clearly erroneous finding regarding the "nature of the work" factor. Here, the incentive interests, in our view, balance the equitable scales so that the nature of the work factor does not tip decidedly in favor of either party.

3. *The Amount and Substantiality of the Use*

Pursuant to the third factor, "whatever the use, generally it may not constitute a fair use if the entire work is reproduced." 3 Nimmer § 13.05[A], at 13-80. On this point the district court concluded—consistent with its finding that P-1 was not a copyrightable derivative work—that Dr. Freeman's copying of Dr. Weissmann's "slight additions" to the underlying joint work reduced the copying to a "*de minimis*" violation. We disagree.

We have previously held that the fair use privilege is grounded upon reasonableness, which may not be found in cases where there has been extensive verbatim copying or paraphrasing of another's material. *See Rosemont Enterprises*, 366 F.2d at 310. The subject work was impermissibly photocopied word-for-word with the only changes being the modification of the title and the substitution of credit for authorship; such use is patently not reasonable and the trial court's finding that it was *de minimis* is clearly erroneous.

4. *The Effect on the Market for or Value of the Work*

The fourth factor is the most important one in determining fair use. With respect to it, the district court held that Freeman's use of P-1 would not impair its market value, and stated that "dissemination of the results of the research being done at Montefiore would in all likelihood only increase the 'marketability' of a paper emanating from that department." 684 F. Supp. at 1262. Although it is self-evident that publication may increase marketability of departmental papers generally, we disagree with the district court's conclusion that this factor weighed in favor of Dr. Freeman. Dissemination in appellant's name, or in the names of both parties, would have had exactly the same effect in the market.

The Senate Report on the § 107 codification of the fair use doctrine states that "[w]ith certain special exceptions . . . a use that supplants any part of the normal market for a copyrighted work would ordinarily be considered an infringement." S. Rep. No. 473, 94th Cong., 1st Sess. 65 (1975). In our view, the particular market at issue here—namely, the world of scientific research and publication—functions in such a way as to encourage the creation and

dissemination of papers such as P-1. *See Harper & Row*, 471 U.S. at 566 n.9. Because a copyright is used as a stimulant to creative effort, *see Sony Corp.*, 464 U.S. at 450-51, it undercuts the congressional copyright scheme to rule in a manner destructive of this creativity.

The rewards that Congress planned for copyright holders of scientific works to reap arguably include promotion and advancement in academia, where tenure decisions are often based on a "publish or perish" approach. In scholarly circles such as, for example, the small community of nuclear medicine specialists involved in this suit, recognition of one's scientific achievements is a vital part of one's professional life. The fact that Dr. Freeman's planned use of P-1 was for the same intrinsic purpose as that intended by Dr. Weissmann not only undermines Dr. Weissmann's ability to enjoy the fruits of her labor, but also creates a distinct disincentive for her to continue to research and publish in the field of nuclear medicine. Hence, to rule that this was a fair use would tend to disrupt the market for works of scientific research without conferring a commensurate public benefit. The district court's error on this fourth factor was in focusing on sales or dollars received, rather than upon the realities of promotion and tenure in an academic setting.

As earlier noted, the fair use doctrine is a flexible one that must be viewed in light of the particular circumstances of each case. When all of the statutory factors are considered in the context of scholarly scientific research and publication, they weigh against Dr. Freeman's right to invoke the fair use defense in Dr. Weissmann's infringement suit against him.

IV *Denial of 15(b) and 60(b) Motions*

Dr. Weissmann also appeals the denial of her post trial motions under Fed. R. Civ. P. 15(b) and 60(b). At the close of the trial, she moved under Rule 15(b) for leave to amend her complaint to conform to the proof and to add certain factual allegations concerning Dr. Freeman's submission of the so-called Taiwan Publication, and to add causes of action for copyright infringement, Lanham Act violations, and common law unfair competition. Essentially, appellant alleged that the trial evidence established that appellee's assertion of joint authorship violated § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a) (1982), and supported her common law claims based on a theory of false designation of origin. *See, e.g., Eden Toys*, 697 F.2d at 37 (incorrect attribution actionable under § 43(a)); *Smith v. Montoro*, 648 F.2d 602, 604-07 (9th Cir. 1981). Judge Pollack denied the motion ruling that it was not timely asserted, insufficiently litigated, and based on unestablished premises.

Weissmann's second motion under Rule 60(b) contained a newly obtained declaration of Professor Chien Chung who served as director of the Taiwan symposium in which an infringing version of P-1 was allegedly published. On the basis of this declaration appellant sought to correct the trial court's supposed factual error in having ruled that the Taiwan Publication has not been proven to be connected with Dr. Freeman. This motion was denied on the grounds that it was not newly discovered evidence and, even if credited, would not alter the result on either the motion to amend or on the merits.

The district court's rulings on both of these motions is reviewable only for an abuse of discretion. *See Grand Light & Supply Co. v. Honeywell, Inc.*, 771 F.2d 672, 680

(2d Cir. 1985); *Altman v. Connally*, 456 F.2d 1114, 1116 (2d Cir. 1972). Because we cannot say on this record that the district court abused its discretion, we affirm its denial of appellant's post-trial motions.

V *Attorney's Fees*

As a cross-appellant, Dr. Freeman argues that the district court erred in denying an award of attorney's fees and sanctions. He also seeks sanctions and attorney's fees in this court arguing that Weissmann's appeal is frivolous. Obviously, we disagree with the latter assertion, and an award of attorney's fees to appellee is inappropriate in light of our holding. Their denial in the district court is also affirmed. *See Roth v. Pritikin*, 787 F.2d 54, 57 (2d Cir. 1986) (award of attorney's fees lies within sound discretion of court); *Diamond v. Am-Law Publishing Corp.*, 745 F.2d 142, 148-49 (2d Cir. 1984) (same).

CONCLUSION

For the reasons stated, we hold that P-1 was an individually-authored, copyrightable, derivative work created by appellant and that Dr. Freeman's use cannot be said to be a fair use of it. Accordingly, we reverse the judgment of the district court and remand the case to it with directions that judgment be entered in favor of appellant Weissmann. The judgment otherwise appealed from is affirmed.

Reversed in part and affirmed in part.

PIERCE, *Circuit Judge*, concurring:

I join in Parts II-V of the court's opinion. I join only in the result in Part I.

As to Part I, I agree that we must reverse and remand because Dr. Freeman failed to rebut appellant's claim (evidenced by her registration of P-1 as a derivative work) that she did *not* intend the new material to be "merged" with the prior joint work. *See generally* 1 M. Nimmer, *Nimmer on Copyright* § 6.03 (1988). Appellant's certificate of registration served as "prima facie evidence of the validity of the copyright and of the facts stated in the certificate." 17 U.S.C. § 410(c) (1982). For Dr. Freeman to claim that his use was not an infringement, but rather that the work was "joint," was a defense much like any other under the Copyright Act. *See* 3 M. Nimmer, *supra*, § 13.04. Therefore, it was incumbent upon Dr. Freeman to rebut appellant's prima facie evidence that the work (P-1) was derivative, not joint. Appellee failed to meet his burden, however, for he failed to present sufficient evidence to demonstrate appellant's intent to create a joint work.

The district court appears to have applied the opposite presumption. Rather than focusing on the appellant's intent at the time of creating the derivative work, the court dwelt primarily on the parties' long-standing and close professional relationship. From that, it seems to have presumed that P-1—a by-product of that professional collaboration—was a "joint" work. That presumption, however, in effect placed the burden on the putative author to show that the work was derivative, rather than on the putative infringer to show that the work was joint. The district court's approach was therefore at odds with

the statutory scheme of burdens of proof, and must be reversed as a matter of law.

I differ, though, with Judge Cardamone's reasoning in Part I. The fact that Dr. Freeman was not the author of any of the new material that went into P-1 did not, of itself, preclude that work from being "joint." Of course, as Judge Cardamone notes, one cannot be found to be a joint author of a work without actually having contributed to that work. *See* 1 M. Nimmer, *supra*, § 6.07. However, that does not mean that an author, to be a "joint" author, must have contributed to each incremental addition to the work. Thus, in this case, had Dr. Weissmann's intent been otherwise—had she intended the work to be joint—Dr. Freeman could have been deemed a joint author simply by virtue of his contributions to the earlier work, into which Dr. Weissmann's material would have been "merged." *See, e.g., Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F.2d 266, 267 (2d Cir. 1944); 1 M. Nimmer, *supra*, § 6.03, at 6-7.

Further, I do not agree that the earlier incorporation of Dr. Freeman's "False Positives" study into the evolving syllabus was irrelevant. Though not dispositive, the parties' past willingness to have their works absorbed into the syllabus was relevant to the question of appellant's intent when she reshaped the syllabus into P-1.

On balance, however, I agree with the court that the evidence relied upon by appellee was not sufficient to show that appellant intended to create a joint work. Therefore, I join the conclusion of the court, and would reverse and remand, with judgment to be entered for appellant.

LUMBARD, *Circuit Judge*, dissenting:

I dissent, and vote to affirm the judgment of the district court in all respects, for the reasons stated in Judge Pollack's thorough and reasoned opinion. 684 F. Supp. 1248 (1988).

Appendix B

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

87 Civ. 6069 (MP)

HEIDI S. WEISSMANN, M.D.,

Plaintiff,

—v.—

LEONARD M. FREEMAN, M.D.,

Defendant.

DECISION AND OPINION

APPEARANCES:

VLADECK, WALDMAN, ELIAS & ENGLEHARD, P.C.
1501 Broadway
New York, New York 10036
By: Judith P. Vladeck
Julian R. Birnbaum
Jill R. Roisen
Attorneys for Plaintiff

SUMMIT ROVINS & FELDESMAN
445 Park Avenue
New York, New York 10022
By: Guy R. Fairstein
Attorneys for Defendant

MILTON POLLACK, *Senior United States District Judge*

In an uncommon controversy, the issues presented are whether a medical paper represents joint or individual authorship and whether it may ground an infringement claim under the Copyright Act, 17 U.S.C. § 101, et seq. The action was tried to the Court at a Bench trial.

The parties are both nuclear medicine physicians. The plaintiff, Heidi S. Weissmann, M.D. ("Weissmann") charges infringement by the defendant, Leonard M. Freeman, M.D. ("Freeman"), of a syllabus entitled "Hepatobiliary Imaging"

which she presented at a nuclear medicine refresher course sponsored by the Radiological Society of North America ("RSNA") in 1985. A booklet containing the syllabus compiled the papers submitted by the physicians lecturing at the RSNA course and was copyrighted by RSNA.

Two years later, Freeman planned to utilize a copy of the same syllabus at a nuclear medicine review course ("the review course"), where he was to be the lecturer at a seminar scheduled for August 24-27, 1987, at the Mount Sinai School of Medicine ("Mount Sinai"). Only two changes were made in the syllabus: 1) plaintiff's name, which appeared at the upper right corner of alternate pages in the 1985 syllabus, was deleted from the Mount Sinai 1987 review course syllabus and replaced with defendant's name; and 2) the title "Hepatobiliary Imaging" used on the earlier syllabus, was changed in the 1987 syllabus to "Gastrointestinal Nuclear Medicine Hepatobiliary Imaging".[1]

Prior to the date for the Mount Sinai review course, plaintiff obtained a copy of the syllabus which was to be handed out to the attendees. On August 19, 1987, she inquired from RSNA whether it had given permission for the use described above. The RSNA told plaintiff that no permission had been sought by anyone for such use.

Plaintiff thereupon requested the director of the review course not to circulate the syllabus and to inform all recipients that she claimed sole authorship thereof. The administrator at Mount Sinai was similarly advised. It was quickly decided that the material would be removed from all copies of the review course handouts and the nine copies already distributed to employees were retrieved. Freeman had no objection to the removal of the disputed material from the lecture hand-outs and went on with the review course lecture without it.

Nonetheless, on the next day, August 20, 1987, this suit was filed, alleging copyright infringement in violation of 17 U.S.C. § 501 and seeking a preliminary injunction. In her prayer for

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1 This work describes a technique involving the injection of radioactive isotopes into the blood, their uptake in the liver and their subsequent secretion in the bile. The areas outlined by the injected substance are then photographed to permit the diagnosis of liver and biliary disorders.

relief, plaintiff sought: a declaration that Freeman had committed actionable infringement; an order permanently restraining him from infringement; an award of actual damages and profits; and full costs and attorneys' fees.

Plaintiff then amended the complaint to seek, in addition to declaratory and injunctive relief, damages only with respect to defendant's economic gain from the alleged infringement and statutory costs and attorney's fees. The claim for attorneys' fees was dismissed at the close of plaintiff's case, with plaintiff's consent, because the copyright was not registered before this suit was commenced and registration is a statutory prerequisite to such a claim. 17 U.S.C. § 412.[2] Jurisdiction herein is based upon 28 U.S.C. § 1338(a) and 17 U.S.C. § 501(b).

Several months after inception of this suit, plaintiff obtained a registration of a copyright in her name covering the same syllabus she had used in 1985 at RSNA. The registration was issued to her on November 9, 1987 and states her contention to the Register of Copyrights that the copyrightable material in the syllabus consists of "amplification, revision and reorganization of pre-existing material; review and update of relevant literature to add new references; substantial new textual material and compilation of photographs." Plaintiff relies on the registra-

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2 Copyright registration is a prerequisite to the filing of an infringement suit. 17 U.S.C. § 411. Plaintiff herein commenced this action by filing a complaint on August 20, 1987. Plaintiff's copyright registration is dated November 9, 1987; thus, she was technically not entitled to have instituted this action at the time. Plaintiff amended the complaint nunc pro tunc, however, to allege registration of the copyright. The parties agreed to the amendment of the complaint by stipulation dated March 8, 1988. Plaintiff was thus entitled to maintain this action. *See Conan Properties, Inc. v. Mattel, Inc.*, 601 F. Supp. 1179, 1182 (S.D.N.Y. 1984) (a defect "can be cured simply by filing a second amended complaint, which relates back to the commencement of the action, and which includes a recitation that the registration requirement has been satisfied"); *Frankel v. Stein and Day, Inc.*, 470 F. Supp. 209, 212-13 n.2 (S.D.N.Y. 1979) (permitting amendment of the complaint, especially in light of the fact that the defendant did not object to this), *aff'd*, 646 F.2d 560 (2d Cir. 1980); *Eden Toys, Inc. v. Florelee Undergarment Co.* 697 F.2d 27, 33 (2d Cir. 1982) (permitting amendment of the complaint even though plaintiff apparently did not register the copyright until after defendant's alleged infringement).

tion issued to her as well as the registration of the RSNA booklet.

Defendant denied liability for infringement and asserts that the syllabus was the product of lengthy collaborative research and joint authorship, largely copied verbatim from earlier papers created either solely by him or in whole or in part in his role as principal investigator, collaborator, writer and chief of the nuclear medicine department in which plaintiff was employed; that he was entitled to use the paper as stemming from his own contribution to the syllabus, for lecture, teaching and study purposes; that it was a fair use; and that the content was in the public domain. Further, in his Answer, defendant seeks 1) a declaration that he and plaintiff are joint authors of the allegedly infringed work, 2) a dismissal of the amended complaint and 3) costs and a reasonable attorney's fee.

I. *Background*

To place the dispute in focus, it is necessary to consider: the origin and development of the syllabus in light of the parties' relationship, the stature of the defendant in the medical profession and in the field of nuclear medicine in particular, the development of the plaintiff's career in the field under defendant's supervision, guidance and control as defendant's junior associate, and the parties' use of radioactive substances on humans in imaging of the gall bladder and liver under authorizations issued to defendant alone.

From the inception of the parties' professional association in 1977 to plaintiff's termination in 1987, defendant was the Chief of the Division of Nuclear Medicine at Montefiore Medical Center ("Montefiore") and plaintiff, starting as a fourth-year radiology resident under defendant, was the developing junior member of the association. Their work was laid down in papers, syllabi and articles, in evolutionary stages, jointly conceived and executed. Each had a hand in propelling that evolution. To a large extent it was plaintiff's part of the joint enterprise to write down the results of their activity, with defendant always on top of what was in progress, by actually supervising the investigations, writing portions of papers, reviewing

drafts, commenting on the scripts and lending credibility thereto and to the project by his standing, reputation, knowledge, perception, and experience.

The item presently under consideration ultimately evolved in that manner. The writing at issue here was no more than a stock piece of what the parties had already worked up, nothing new or newly communicated, merely freshened up to take in evolutionary detail on what had already been compiled; it did not report any new studies.

In those circumstances, in August 1987, when invited to speak at a review course at Mount Sinai, the defendant felt comfortable in planning to hand out the syllabus at the course. He placed his name on the hand-out rather than plaintiff's, since she was not scheduled to give any part of the review lecture on that occasion. Plaintiff's sensitivity to this conduct, which to her was a seeming by-pass of her participation in the work, galvanized this suit, with its highly emotional overtones and accusatory concepts. Suffice it to say the piece was not used by the defendant and he delivered the lecture without a syllabus hand-out.

II. *In More Detail*

A. *The Parties*

1. The Defendant—Freeman

In the order of seniority, we discuss the defendant first—the Chief of the Department of Nuclear Medicine at Montefiore. Freeman is Board Certified in Radiology, Nuclear Medicine and Diagnostic Radiology, with special competence in Nuclear Radiology. He is a professor of Radiology and of Nuclear Medicine at the Albert Einstein College of Medicine ("Einstein"), where he has held faculty appointments since July 1964, is an attending physician in Radiology and Nuclear Medicine at Montefiore and also serves as Director of the Nuclear Medicine Service at Montefiore and Vice-Chairman of the Department of Nuclear Medicine at Einstein.

Freeman was President of the Society of Nuclear Medicine in 1979-80, President-Elect of the Society in 1978-79 and its Vice-

President in 1977-78. He holds editorships in specialty publications: co-editor of "The Seminars in Nuclear Medicine," now in its 18th volume; co-editor of "Nuclear Medicine Annual"; co-editorial consultant of the *Physicians' Desk Reference for Radiology and Nuclear Medicine*; medical editor of "Current Concepts in Diagnostic Nuclear Medicine"; and editor of a textbook called *Freeman and Johnson's Radionuclide Imaging*. Freeman is well-published in diverse areas of nuclear imaging, including hepatic (liver), renal (kidney), and bone imaging, especially using Rose-Bengal, the forerunner of the radioactive material referred to as the IDA compounds. It is evident from Freeman's curriculum vitae and list of major presentations that Freeman is a prolific author on a broad range of organ systems susceptible of diagnosis by radionuclide imaging, a much sought-after speaker at national and international meetings and before professional societies and medical institutions and an esteemed physician and researcher in the field of nuclear medicine and radiology.

2. The Plaintiff—Weissmann

Plaintiff is a graduate of Mount Sinai School of Medicine and licensed to practice medicine in the State of New York. At the time plaintiff commenced this action, she held appointments as an associate professor of Nuclear Medicine and Radiology at Einstein and as an attending physician employed by Montefiore.

Weissmann began her professional association with the defendant in the fourth year of her residency in radiology at Montefiore in July 1977. Weissmann spent the following year at New York Hospital-Cornell Medical Center for a fellowship in ultrasound and in July 1979 returned to Montefiore as an adjunct attending physician and to Einstein as an instructor in Radiology. Although Weissmann's specialties are Nuclear Medicine and Radiology, she is not Board Certified in either. She has taken only the written portion of the certification examination.

In 1979, Weissmann received the President's Award of the American Roentgen Ray Society for a paper of which she was

the first-named of four authors. Weissmann was honored in 1980 as a recipient of the Distinguished Alumnus Award of the Mount Sinai School of Medicine. In 1982, she received the Tetelman Award of the Society of Nuclear Medicine, awarded annually to an outstanding investigator in the field of nuclear medicine under thirty-five years of age. Her curriculum vitae lists as published, or in press, 34 journal articles, 33 abstracts, and nine book chapters, of which Weissmann is author or co-author. Virtually all of her published works relate to radionuclide imaging of the biliary tract. Weissmann has been enthusiastically received at numerous meetings where she lectured on the subject and her expertise has been recognized.

B. *The Radiopharmaceutical "IDA"*

From 1966 to 1973, Freeman published in the areas of hepatobiliary problems. In the latter part of 1976 and early 1977, he became involved with the application of derivatives of a radionuclide, iminodiacetic acid ("IDA"), a substance labelled with the isotope technetium and injected into the blood so that it can be picked up by the liver and simulate the flow of bile, allowing diagnosis of liver and biliary disorders. Merck-Frosst, the Canadian manufacturer of an IDA analog known as HIDA, was interested in obtaining American investigators with the appropriate tools, laboratories and reputations in order to develop a patient data base to support the company's application for approval from the Food and Drug Administration ("FDA") to distribute the pharmaceutical in the United States. The company acquired an investigational new drug ("IND") authorization from the FDA and contracted with five physicians, of which Freeman was one, to conduct studies using this new substance. That was the project on which plaintiff served under defendant for several years since 1977. In the past three to four years, scientists have almost exhausted their investigations of this agent, and most researchers who have been involved in this area have moved to other areas of interest.

In addition to the required authorization (IND) from the FDA, very specific approval to perform studies with this agent had to be obtained from two committees at Montefiore: (i) the Institutional Review Board and (ii) the Committee for Human Isotope Usage, which dealt with the administration of radioactive material to human beings.

The principal investigator identified and authorized by the FDA and the Montefiore committees with regard to the IDA agent was Freeman. Because of the FDA and Montefiore approvals granted in his name, Freeman was an essential element in all IDA work done at Montefiore, at least until 1982 when one agent was licensed by the FDA for use other than on an experimental basis. The FDA authorized Freeman's use of the IDA analog initially under the Merck-Frosst IND authorization and thereafter under his own IND. Freeman was subsequently authorized by the FDA to use other IDA derivatives, including agents manufactured by New England Nuclear Corporation and Squibb.

Later, Weissmann was authorized to use one particular IDA analog, that manufactured by Amersham Corporation. However, even that analog was used under the Montefiore approvals given to Freeman.

In addition, Montefiore approved an informed consent form, to be signed by patients before being subject to IDA use; the form ran in favor of "Dr. L. Freeman and associates."

Freeman's role as principal investigator with respect to the IDA analogs meant, in Weissmann's own words, that the "buck stops" with Freeman. Articles jointly published in both Freeman's and Weissmann's names based on 90- and 323-patient studies included patients whose case histories were reported back to the pharmaceutical houses with respect to whose IDA agents Freeman was the principal investigator.

The investigations using IDA derivatives at Montefiore were initiated due to Freeman's reputation in the field of nuclear imaging. He possessed the IND authorizations and the Montefiore approvals to administer the drug, and the patients, who signed informed consent forms bearing Freeman's name, were referred to the department over which he presided and for which he was ultimately responsible.

C. *The Evolution of Plaintiff's Exhibit 1 ("P-1")*

The parties began collaborating on and pursuing a common design of investigating the use of IDA derivatives while Weissmann was a fourth-year resident. They published their first jointly authored article concerning IDA scanning, or scintigraphy, in January 1979. A series of journal articles followed over the next several years on the use of IDA scanning in diagnosing biliary diseases, published in the names of Weissmann, Freeman and other investigators.

The allegedly infringed syllabus ("P-1") originated as a result of this collaboration between the plaintiff and the defendant. The work in which plaintiff claims a copyright is a syllabus—a review paper providing an overview of the potential and of the current state of the art of specific research being done in the particular field, in this case hepatobiliary imaging techniques. Syllabi are papers that accompany lectures and are distributed to attendees of refresher courses and other educational meetings. Medical residents, for example, use such review course syllabi to study for specialty boards. As opposed to journal articles, a syllabus usually does not report original research.

Beginning in about April 1980, Freeman and Weissmann together prepared a syllabus to submit to the sponsors of refresher courses at various medical centers.

Plaintiff testified, in substance, that from the very beginning when she started as a resident, Dr. Freeman had made it clear to her that there are different kinds of articles that "we" write; as to journal articles, for example, plaintiff said that it was clear Freeman expected his name to be added to them when done and submitted by any physician in his division. Plaintiff acquiesced in that procedure; she testified that "he was responsible for what I was saying, but I really was doing the primary research."

Weissmann and Freeman spent their professional association in offices in close proximity to each other, with frequent consultations between them throughout the day. She "would get input from him as to his opinions and directions, based on his experience. Mentioning his name lent authority" to what the plaintiff was doing. Plaintiff did all of her writing pertinent to this lawsuit while she was affiliated with Montefiore in defendant's

department. Of the writings that are reported in her curriculum vitae, and those that are not, plaintiff did almost all of the writing, but she submitted drafts to Dr. Freeman before publication. She would always make sure to leave a copy of a manuscript on his desk if he was not in town or busy with other commitments; she did not always get the articles back, but often she did. Taking the list of articles on her curriculum vitae, plaintiff testified that Dr. Freeman was co-author on not all but most of the articles.

The plaintiff admitted that her activity with Freeman involving IDA biliary imaging agents was collaborative on some occasions. It was pointed out to her that in her vitae, 30 of the 34 journal articles appear in the names of Freeman and Weissman, either together or with others, 32 of the 33 abstracts bear her name and Freeman's, either together or with others, and 5 of the 9 book chapters identify Weissman and Freeman as co-authors together or with others. Plaintiff admitted that there was no peer-reviewed paper or abstract of which the plaintiff was the author or co-author that is not listed in her vitae. Significantly, there is no review course syllabus listed in her vitae.

P-1 is a 1985 update of a continually evolving stock piece of a syllabus used by the parties and continuously styled in the same general format to accompany many of their review course lectures commencing in April 1980; as indicated previously, exhibit P-1 did not report anything of substance that was new in the field.

The stock piece was first prepared for use at a forthcoming April 1980 nuclear medicine review course sponsored by Harvard Medical School. Freeman testified that it was he who was invited to lecture on hepatobiliary imaging at this review course, and he secured an invitation for Weissmann to participate with him. Although Weissmann initially claimed to have had a direct invitation to lecture at Harvard in 1980, Weissmann later conceded that she might have been invited to participate as lecturer through Freeman and could not really remember. Freeman's testimony gives the more believable version. Weissmann and Freeman jointly prepared the syllabus to be handed out at the 1980 Harvard course. Attached as the first annex to the Harvard 1980 course syllabus is a 1979 paper in

which Freeman's input was an integral part. Weissmann relied quite heavily upon Freeman to put a manuscript together and teach her how to construct a paper compiling the data that had been gathered.

A few weeks prior to the lecture at the Harvard 1980 review course, a nuclear medicine review course was conducted at Einstein at which Weissmann lectured and for which plaintiff submitted a syllabus by-lined in her name alone. Freeman credibly testified that Weissmann did not have a syllabus ready for submission to that Einstein course as the submission deadline approached, so Freeman suggested that she look at the syllabus they together had already prepared for the Harvard course, which had an earlier submission deadline, and make minor revisions to it. The Einstein 1980 review course paper was actually prepared after the paper for the Harvard 1980 review course.

The Einstein 1980 paper is virtually identical with the Harvard 1980 paper of which Freeman was a co-author; there are minor changes in word order and two or three additional sentences in the Einstein syllabus. Freeman was co-author of the Einstein 1980 paper as well. Freeman was a co-director of the Einstein 1980 review course and Weissmann necessarily acted under Freeman's aegis when she submitted the paper there under her name alone. This is some indication of a practice that, rather than designating the authorship, the by-line name appearing on such review course material was utilized as an identification of the reviewer or lecturer who was to appear before the audience.

The standard piece continued to be used by the parties as review course syllabi in succeeding years. Not all subsequent versions of the paper were received in evidence, but the Court did receive the paper as submitted for the following nuclear medicine review courses: Harvard 1982, Einstein 1983, Harvard 1984 and Mount Sinai 1984. There are minor variations in the syllabi preceding the 1984 papers. The Harvard 1982 syllabus uses figures, which appear in the Einstein 1983 syllabus also. The main thrust of the Harvard 1984 syllabus, which is by-lined with Freeman's name alone, is a new section on so-called "false positive" studies composed by Freeman alone. That paper omits several other sections previously used and appears to be a

somewhat abbreviated hand-out. The Mount Sinai 1984 syllabus, which lists Weissmann in the byline, contains all sections used in prior versions of the paper including the new false positive section but omits figures. The latter two syllabi are in a slightly different format than their predecessors.

Substantial portions of P-1 were taken verbatim from prior review course syllabi and other jointly authored works of the parties. The Einstein 1983 and Mount Sinai 1984 review course papers are copied virtually verbatim almost in their entirety in P-1. The "Chronic Cholecystitis" and "Cholestasis" sections of P-1 are in fact taken virtually verbatim from both the Harvard 1980 paper and the parties' jointly authored chapter in a book edited by one, Serafini. Neither of the parties felt it necessary to obtain permission for such use from the publisher-copyright holder of the Serafini book before submitting the educational paper P-1 to the RSNA.

In describing the recommended technique of administering the radiopharmaceutical, P-1 expressly attributes the recommendation to "we," *i.e.*, clearly a reference to Weissman and to her collaborator. Weissman was not alone in creating this work or its predecessors, but received the active participation of her mentor and colleague in what was a collaborative effort to research and report the state of the art in hepatobiliary imaging.

D. *Joint Authorship*

The parties had agreed, at least impliedly if not overtly, that the stock piece could be used as a handout by either of them, in their individual or joint names, to accompany the teaching review course lecture in which the individual was the assigned lecturer.

Weissman and Freeman unquestionably were collaborators in their investigation of the various IDA analogs they used at Montefiore and joint authors of the syllabi and of many of their journal articles, abstracts and book chapters concerning hepatobiliary scintigraphy using technetium-labelled IDA analogs.

Freeman's participation is strikingly illustrated by inclusion in P-1 of the section entitled "False-Positive Studies for Acute Cholecystitis," which unquestionably he composed. His

authorship thereof was unequivocally established at the trial. In May 1983, Freeman had been invited to speak at Harvard's review course to be held the following year. Several articles had begun to appear in the literature criticizing the use of IDA imaging procedures and reporting "false positive" results in studies using these procedures. A "false positive" occurs when a test result indicates that a patient has a particular condition (acute cholecystitis) but is later found in fact not to have that condition. In accepting the invitation to speak at Harvard in 1984, Freeman told the sponsors of the course that he would address the issue of IDA scanning, its interrelationship with other imaging procedures and the reported false positive results.

Freeman had already planned to address that topic of reported false positives, or hepatobiliary "pitfalls," at a presentation to be given in October 1983 at Case Western Research School of Medicine to the Cleveland Radiological Society. Freeman wrote his choice of a lecture topic in a letter dated February 24, 1983 to a Dr. LiPuma at Case Western. Freeman prepared a set of "false positive" slides, representing the most current state of hepatobiliary scintigraphy, as an accompaniment to the Cleveland lecture, to be given in October 1983. He further testified that he kept two copies of those slides and gave one copy to Weissmann for her use.

Freeman had a long-standing interest in false positive studies, illustrated by his February 24, 1983 letter referring to "pitfalls" and his letter to a Dr. Berk dated September 6, 1983 on that very subject. The compelling proof of his having prepared the "false positive" slides was buttressed by his use of them on October 18, 1983 at the New York Hilton, even before the Cleveland lecture, portrayed in a videotaped debate with Dr. Laing, produced in evidence as Defendant's Exhibit 48. A review of the videotape of Freeman's performance at the Freeman/Laing debate substantiates even further a finding that it was Freeman who was actively involved in the creation of these slides.

Subsequently, with Freeman's lecture at the 1984 Harvard review course approaching, Freeman authored as an accompaniment to his appearance a submission for the course which dis-

cussed the reported false positive IDA studies, incorporating material from the slides he had used in Cleveland. Freeman individually was the author of the "false positive" matter contained in the Harvard 1984 syllabus, which was submitted with Freeman's name alone for his lecture there.

Weissmann also spoke on the subject of reported false positives, using slides; however, the earliest such occasion was in November 1983, subsequent to Freeman's lecture in Cleveland. Weissmann had no response to the graphic evidence in defendant's Exhibit 48 and failed to contradict with credible evidence the conclusive proof in favor of defendant's claim of authorship of the slides used and of the lengthy section in P-1 of the false positive discussion.

Indicating the mutual use of the collaborative efforts, Weissmann lectured at the Mount Sinai nuclear medicine review course in 1984, and in connection with the lecture she submitted a hand-out entitled "Hepatobiliary Imaging." Although this paper by-lined only her own name, it incorporated Freeman's "false positive" section verbatim from the Harvard 1984 paper as well as all of the other sections created earlier by the collaborative effort and used in the syllabi for prior review courses.

E. *New Matter*

Plaintiff contends that the questioned article contains new matter and non-trivial originality; that it has variations which are sufficient to render it meaningfully distinguishable from the prior forms of the work from which it was drawn. It is not the proper function of this Court to consider whether the alleged new work is a qualitative improvement over the prior work in determining the scope of copyright protection. 1 *Nimmer* on Copyright § 3.03 at 3-10 [hereinafter "Nimmer"]. "It would be a dangerous undertaking" for the Court to constitute itself the final judge of the "worth" of the work. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903). The Court addresses originality, not novelty. *L. Batlin & Son v. Snyder*, 536 F.2d 486, 490 (2d Cir.), *cert. denied*, 429 U.S. 857 (1976). However, the Court was provided with the best qualified expert opinion on the appearance or absence of new matter and of

non-trivial originality, that of the defendant, the acknowledged outstanding expert in the field. The plaintiff merely echoed legal language found in the reported cases in asserting that she had presented some new and additional expression in P-1. P-1 was portrayed by the plaintiff as the product of a month's effort and the review of more than 100 works in the literature. However, only four new references were added: two citing the illustrations reproduced with permission, both of which were originally prepared by Freeman, one citing to a work jointly authored by the parties, and one citing to a work that reported a procedure disfavored by the parties.

The defendant testified that there was nothing new expressed. Only trivial variations were stated in P-1, adding nothing, and the paper was only the old stock piece updated. Certainly there was nothing sufficiently substantial in its originality to merit protection under the Copyright Act. Significantly, by 1985, interest in IDA had already peaked: "most of everything that has had to be done with this agent has become established and most investigators who have been involved in this area have moved on to other areas." P-1 was just the "most recent version of the piece that Dr. Weissmann and [Dr. Freeman] had been using since 1980 with various minor revisions and update and cutting and pasting that had been done in its use over a seven-year period."

No corroboration from any independent qualified source was supplied by the plaintiff for her contrary assertions. After defendant's convincing rebuttal of the presumption of originality of the allegedly infringed work, the plaintiff then had the burden of going forward on the issue; that she failed to do. The matter was not self-proving.

F. *Mount Sinai 1987*

Weissmann was on sabbatical leave from her employment at Montefiore in 1987. Freeman was invited in that year to lecture at a review or teaching course at Mount Sinai. Freeman instructed his secretary to prepare P-1 for use in the 1987 Mount Sinai review course, to place his name on the handout syllabus in place of Weissman's name used on the 1985 RSNA

handout and expand the title by adding three words. Freeman justified this "copying" with the belief that he was using the jointly prepared stock piece for a syllabus handout at an educational review course lecture which he alone was scheduled to give.

Fifty copies of the 1987 review course syllabus were run off; nine copies were distributed to Mount Sinai staff physicians; all of these were retrieved and not used. Plaintiff, learning of the lecture and of the proposed handout, protested the omission of her name through counsel. Plainly, to raise a legal question of that kind at the last moment before the lecture was necessarily to disrupt the arrangements for the lecture. To avoid controversy with plaintiff at that moment, Freeman promptly directed the withdrawal of the proposed syllabus and proceeded to lecture without a syllabus handout. The only extant copy of the course booklet containing the form in which Weissmann's name was omitted was the copy that came into the possession of Weissmann.

G. *Credibility*

On the many issues to be resolved in determining this action, the testimony of the parties was squarely in contradiction. These issues include: the extent to which Freeman had participated in the investigation of IDA as a diagnostic tool; the extent to which Freeman had participated in the preparation of papers and other works published in the names of both parties, as coauthors, on the subject of hepatobiliary imaging; the preparation and content of the various review course syllabi and the modifications from time to time thereof as well as the repetition of the content prior to Weissmann's submission of the paper allegedly infringed; whether Freeman's name appeared on these numerous prior publications because he, as Weissmann's "chief" and mentor, had requested that he be listed as an author even though he had not contributed to the work, or, because he had in fact collaborated as an author; and whether Weissmann had ever previously exacted from Freeman any conditions upon his use of "her" work. These and other controverted matters were raised and considered.

Shortly before the end of the trial the Court asked the plaintiff directly whether she claimed that defendant had any participation at all in the content of the syllabus. The colloquy was as follows:

Q: Is there anything recited in plaintiff's Exhibit 1 which were the words and work of Dr. Freeman on a prior occasion?
A: None at all. This is my words, my work, my expression. Dr. Freeman had no participation in it.
Q: Are there sections, paragraphs, sentences in there, which were the words and work of Freeman on a prior occasion?
A: Not a single word.

The physical evidence and the credible testimonial proof were all to the contrary of those flat denials.

The Court had the opportunity, during the four days of trial, to consider the proofs and observe the demeanor of the parties as witnesses. Based upon the parties' testimony and demeanor, illumined by the documentary evidence and the testimony of non-party witnesses, the Court resolves the issues of credibility in favor of defendant, and against the plaintiff. At the point of the trial when the slides dealing with the false positive issue were demonstrated, the Court was expressly constrained to find on the record after the physical demonstration made of the slides on a projector that the only credible explanation of authorship was that of Freeman. This necessarily stamped as Freeman's the type-script from which the slides shown in Cleveland and at the Hilton Hotel were made and which furnished the text in the Harvard 1984 syllabus and eventually Exhibit P-1.

The Court finds, based upon all of the facts and circumstances in evidence, that there was no violative use of Exhibit P-1 by the defendant.

During the course of Weissmann's direct examination, the Court overruled a defense objection with a statement of its desire to find out why this controversy had come to court. Judging by the hostility evident in Weissmann's demeanor and testimony, the answer appears to be that this action was

brought for personal reasons—be they grievances against Freeman himself or against Montefiore, for reappointing her on a probationary basis and then failing to rehire her at all—that go beyond and are outside of a claim of copyright infringement.

The defendant had recognized the outstanding abilities of his student and junior associate and had created every opportunity possible to promote Dr. Weissmann professionally, enabling her to advance her career significantly in a relatively short period of time.

There is no question as to plaintiff's stature, ability or reputation as a remarkable researcher and specialist in the area of hepatobiliary imaging. But, in short, it was the defendant who opened the doors for Dr. Weissmann, making all of her research and writing possible and professionally recognized. The defendant was the one who had acquired the radiopharmaceutical from the manufacturer as a result of his renown in the medical community and his interest in staying on the cutting edge of medical technology. Even when the plaintiff was able to obtain a radiopharmaceutical in her own name, the defendant was ultimately responsible for the use of the drugs, as the person with whom "the buck stops." The plaintiff obtained and made use of the drug only as a result of her association and collaboration with the defendant. The plaintiff admitted that even after she became an instructor, the defendant had ultimate responsibility for the research activities taking place in his department.

It is unfortunate that two such accomplished scientists could not preserve their esteemed positions by resolving their differences in another forum.

III. *The Applicable Law*

A. *Prima Facie Case*

Introduction into evidence of a certificate of registration from the Copyright Office is prima facie proof of ownership. 17 U.S.C. § 410(c); *Durham Indus. v. Tomy Corp.*, 630 F.2d 905, 908 (2d Cir. 1980). Valid copyright protection subsists only in *original* works of authorship. 17 U.S.C. § 102(a); *Durham Indus.*, 630 F.2d at 908-09. A certificate of registration thus

constitutes prima facie evidence of the author's originality. 3 Nimmer § 12.11[A] at12-78.

The presumption of the registration's validity is a rebuttabie one, and the burden shifts to the defendant to disprove vaiidity. *Hasbro Bradley, Inc. v. Sparkle Toys, Inc.*, 780 F.2d 189, 192 (2d Cir. 1985); 3 Nimmer § 12.11[A] at 12-80. Once the plaintiff presents a certificate of registration, he or she is relieved of proving "the multitude of facts" upon which issuance of the copyright is based, "unless the defendant, by effectively challenging them, shifts the burden of doing so to the plaintiff." *Carol Barnhart Inc. v. Economy Cover Corp.*, 773 F.2d 411, 414 (2d Cir. 1985) (quoting H.R. Rep. No. 1476, 94th Cong., 2d Sess. at 157, *reprinted in* 1976 U.S. Code Cong. & Admin. News 5659, 5773). Judicial deference is given to the expertise of the Copyright Office—the agency charged with administering the copyright laws—unless "the Copyright Office had no opportunity to pass on plaintiff's claim accurately presented." *Russ Berrie & Co. v. Jerry Elsner Co.*, 482 F. Supp. 980, 988 (S.D.N.Y. 1980). Plainly, there was nothing before the Copyright Office when plaintiff submitted her application for registration of P-1 to enable it to pass accurately on plaintiff's claim.

B. *Joint Authorship*

Section 201(a) of Title 17 U.S.C. provides: "Copyright in a work protected under [the Copyright Act] vests initially in the author or coauthors of the work." The product of joint authorship is a "joint work," in which "each contributor automatically acquires an undivided ownership in the entire work, including all of the contributions contained therein." 1 Nimmer 6.06[A] at 6-14. Even if the respective contributions to the joint work are not equal, each joint author shares equally in the ownership of the work in the absence of an agreement to the contrary. *Id.* § 6.08 at 6-20.

A joint work is one "prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole." 17 U.S.C. § 101. The essence of a joint work is "a joint laboring in fur-

therance of a preconcerted common design." 1 Nimmer on Copyright § 6.03 at 6-6; *see also Picture Music, Inc. v. Bourne, Inc.*, 314 F. Supp. 640, 645 (S.D.N.Y. 1970) (Pollack, J.) ("When two or more authors pursuing a common design together create a single work, they become joint owners of the work . . . ."), *aff'd on other grounds*, 457 F.2d 1213 (2d Cir.), *cert. denied*, 409 U.S. 997 (1972).

As stated in *Donna v. Dodd, Mead & Co.*, 374 F. Supp. 429 (S.D.N.Y. 1974):

> Although traditionally creation of a joint work required a common design which existed before the elements of the work were produced, that requirement has been considerably eroded. Nimmer on Copyright § 69. In [*Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F.2d 266 (2d Cir. 1944)], the Court of Appeals for this Circuit held that a joint work can result from the labors of persons who are strangers to each other and who work at different times, if each contributor contemplates that his work will form part of a whole to which someone else will also contribute. Subsequently, the preconcerted design standard for joint authorship was further relaxed in Shapiro, Bernstein & Co., Inc. v. Jerry Vogel Music Co., Inc. ("*12th Street Rag*"), 221 F.2d 569, modified on rehearing, 223 F.2d 252 (2d Cir. 1955). *12th Street Rag* held that, even if at the time one element of a joint work is created no intent to contribute to a joint work exists, if at any time thereafter the author or his assignee conceives and carries out such an intention, the resulting combination will be joint work.

374 F. Supp. at 430. The continued validity of the *12th Street Rag* doctrine is unclear, and the current Copyright Act, which defines joint ownership, has been said to reject the *12th Street Rag* doctrine. *See* 1 Nimmer § 6.03 at 6-8-9.

The respective contributions of several authors to a single work need not be equal either quantitatively or qualitatively in order to constitute such contributors as joint authors. *Maurel v. Smith*, 271 F. 211 (2d Cir. 1921). However, "each such contri-

bution must, in any event, be more than *de minimis*." 1 Nimmer § 6.07 at 6-18 (citing *Picture Music*, 314 F. Supp. 640).

A joint owner cannot be liable to a co-owner for copyright infringement, since a copyright owner cannot infringe his own copyright. *Donna v. Dodd, Mead & Co.*, 374 F. Supp. at 430. One joint owner may license the work without the other's consent, "subject only to a duty to account." *Id.* at 430-31. Likewise, each joint owner may make revisions and publish the original or the revised work. *Weinstein v. University of Illinois*, 811 F.2d 1091, 1095 (7th Cir. 1987).

As joint author of the 1985 RSNA paper, Freeman can not be liable for copyright infringement. He was entitled to submit the jointly owned product for the August 1987 Mount Sinai review course without Weissman's consent and was merely required to account to Weissman, the joint owner, for any profits derived from use of the work. Freeman received the honorarium, $250, from Mount Sinai for his lecture even without the use of the syllabus in question; he earned no profit at all and has nothing for which to account.

C. *Derivative Works*

The allegedly infringed work does not constitute a "derivative work" either.

17 U.S.C. § 101 defines a derivative work as one "based upon one or more preexisting works." While derivative works are specifically included in the Copyright Act as being copyrightable, 17 U.S.C. § 103, "to support a copyright the original aspects of a derivative work must be more than trivial . . . [and] the scope of protection afforded a derivative work must reflect the degree to which it relies on preexisting material." *Durham Indus. v. Tomy Corp.*, 630 F.2d at 909. This analysis is based upon the premise that " 'the one pervading element prerequisite to copyright protection regardless of the form of the work' is the requirement of originality—that the work be the original product of the claimant." *L. Batlin & Son v. Snyder*, 536 F.2d at 489-90 (quoting 1 Nimmer on Copyright § 10 (1975)); *see* 1 Nimmer § 2.01 at 2-5. This requirement has been interpreted to mean a copyrightable work must contain "some

substantial'' and ''not merely a trivial'' variation. *See Durham Indus.*, 630 F.2d at 910; *L. Batlin*, 536 F.2d at 491. Thus, only non-trivial, original features contributed by the author or creator of a derivative work are entitled to copyright protection. *Id.*

The 1985 RSNA syllabus was merely the ''latest version of the collaborative work'' that had been evolving since 1980. The paper ''was essentially in good part [Freeman's] own work in terms of the false positive section. It had a lot of other collaborative work that [the parties] had evolved as the document appeared and periodically was updated and changed from 1980 on.'' The few sentences and ''paragraph or two'' that Freeman concedes Weissmann may have added to the prior jointly authored works amount to ''only a 'miniscule variation,' demonstrating no more than 'trivial' originality.'' *Past Pluto Productions Corp. v. Dana*, 627 F. Supp. 1435 (S.D.N.Y. 1986) (quoting *Durham Indus.*, 630 F.2d at 910). Only a minimal amount of originality is necessary to warrant copyright protection; however, in the light of the testimony which the Court accepts as credible, Weissmann's contributions updating the prior stock piece jointly authored by Weissmann and Freeman and used by both Weissmann and Freeman for educational review courses constitute '' 'merely trivial' variation[s].'' *Russ Berrie & Co.*, 482 F. Supp at 989 (quoting *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102-03 (2d Cir. 1951)).

Often, the subjective selection and arrangement of data can merit copyright protection. *See Eckes v. Card Prices Update*, 736 F.2d 859, 863 (2d Cir. 1984). However, the identical sections were used in prior papers jointly authored in virtually verbatim fashion and the update was done as part of the evolution of the stock piece; plaintiff's modifications of pre-existing joint works therefore do not warrant protection under the copyright laws.

The prima facie case established by plaintiff's submission of the federal copyright registration has been successfully rebutted by the credible evidence that plaintiff's 1985 RSNA paper itself was prepared from prior works jointly authored by plaintiff and defendant and was an evolutionary stock piece. *See Russ Berrie Co.*, 482 F. Supp. at 987. The plaintiff's modifications to

the prior works are not of sufficient originality to support copyright protection.

D. *Fair Use*

Even if Freeman were not a joint author of the allegedly infringed work, his anticipated use of a copy of P-1 was a fair use.

Section 107 of Title 17 places a limitation on the exclusive right in copyrighted works, stating:

> [T]he fair use of a copyrighted work, including such use by reproduction in copies . . . , for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright.

Four factors are to be considered in determining fair use:

> (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
>
> (2) the nature of the copyrighted work;
>
> (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
>
> (4) the effect of the use upon the potential market for or value of the copyrighted work.

17 U.S.C. § 107.

These enumerated factors "are not meant to be exclusive: '[S]ince the doctrine is an equitable rule of reason, no generally applicable definition is possible, and each case raising the question must be decided on its own facts.' " *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 560 (1985) (quoting H.R. Rep. No. 1476, 94th Cong., at 65 (1976)).

With respect to the first factor, "the crux of the profit/nonprofit distinction is not whether the sole motive of the use is monetary gain but whether the user stands to profit from exploitation of the copyrighted material without paying the customary price." *Id.* at 562. The propriety of the defendant's

conduct is also relevant to the character of the use. *Id.* "[F]air use presupposes that the defendant has acted fairly and in good faith." *Marcus v. Rowley*, 695 F.2d 1171, 1175 (9th Cir. 1983); *Time Inc. v. Bernard Geis Assoc.*, 293 F. Supp. 130, 146 (S.D.N.Y. 1968).

Here, Freeman's contemplated use was entirely non-commercial and for ~~nonprofit~~ educational purposes. Freeman neither profited from the paper's use—he received the promised $250 honorarium even without using the handout—nor stood to profit had he included the syllabus in the course materials. Weissmann's stipulation to limit her damages to Freeman's economic gain, which could not have exceeded $250, indicates that there is no market value attached to P-1. Indeed, no evidence was proffered to prove otherwise. In addition, Freeman believed in good faith that he was entitled to use the stock piece for the non-profit review course.

As for the second factor, "[t]he law generally recognizes a greater need to disseminate factual works than works of fiction or fantasy." *Harper & Row*, 471 U.S. at 563. Moreover, "[t]he fact that a work is unpublished is a critical element of its 'nature.' " *Id.* at 564. *Accord Salinger v. Random House Inc.*, 811 F.2d 90, 97 (2d Cir.), *cert. denied*, 108 S. Ct. 213 (1987). This factor weighs heavily in favor of Freeman. The syllabus here is factual and scientific in nature and it was disseminated by Weissmann herself and published in the 1985 RSNA booklet.

Under the third factor, the general rule is that the use "may not constitute a fair use if the entire work is reproduced." 3 Nimmer § 13.05[A] at 13-79; § 13.05[D] at 13-90.10-13-90.11. Although Freeman copied all of P-1, the content virtually in its entirety had been published in the name of both parties as joint authors, reducing to *de minimis* the very slight additions to the work as already indicated.

The fourth factor "is undoubtedly the single most important element of fair use." *Harper & Row*, 471 U.S. at 566. " 'Fair use is limited to copying by others which does not materially impair the marketability of the work which is copied.' " *Id.* at 566-67 (quoting 1 Nimmer § 1.10[D] at 1-87). Freeman's contemplated use of P-1 would not impair its market value at all, if

any exists, and dissemination of the results of the research being done at Montefiore would in all likelihood only increase the "marketability" of a paper emanating from that department.

On balance, Freeman's was a fair intended use.

IV. *Defendant's Attorney's Fees*

Defendant, in addition to demanding declaratory relief and a dismissal, seeks costs and reasonable attorney's fees pursuant to 17 U.S.C. § 505, based on plaintiff's allegedly meritless claims.

> Fees to a prevailing defendant should not be awarded when the plaintiff's claim is colorable since such awards would diminish the intended incentive to bring such claims. When the plaintiff's claims are objectively without arguable merit, however a prevailing defendant may recover attorney's fees under Section 505.

Diamond v. Am-Law Publishing Corp., 745 F.2d 142, 148 (2d Cir. 1984).

In order to award attorneys' fees to a defendant, a court must find plaintiff's suit to be "baseless, frivolous, unreasonable, or brought in bad faith." *Grosset & Dunlap, Inc. v. Gulf & Western Corp.*, 534 F. Supp. 606, 610 (S.D.N.Y. 1982); *Gardner v. Nizer*, 396 F. Supp. 63, 64 (S.D.N.Y. 1975). "[A] finding of subjective bad faith is not necessary . . . ." *Diamond*, 745 F.2d at 148. Attorneys' fees to a prevailing defendant are to be awarded circumspectly, particularly since they serve the purpose of "penalizing the losing party." *Roth v. Pritikin*, 787 F.2d 54, 57 (2d Cir. 1986). An award of attorneys' fees is within the sound discretion of the Court. *See Diamond*, 745 F.2d at 149; *Warner Bros. Inc. v. American Broadcasting Cos.*, 720 F.2d 231, 248 (2d Cir. 1983).

Plaintiff brought this litigation precipitately and perhaps unnecessarily. She sought to bolster her claims by short-sighted and untrue denials of the collaborative and sometimes personal authorship of the defendant of the stock piece—denials that went so far as to state that Freeman did not participate at all and, in answer to a question from the Court, that not a word,

sentence or thought in P-1 was that of Freeman. Plainly the overbroad position she took resulted in a grave insult to her mentor and professional colleague. Dr. Freeman had neither motive nor need to plagiarize, considering his preeminent grasp of the subject.

Withal, taking into account all of the facts and circumstances shown in the record, the Court believes that the plaintiff's resort to the courts was misguided ego and not essentially to impair the reputation and standing of the defendant. The plaintiff did stipulate that no actual damage resulted and limited her claim to defendant's economic gain from the alleged infringement. *See Grosset & Dunlap*, 534 F. Supp. at 611. It will serve no useful purpose to perpetuate her feuding by imposing attorney's fees, and in an endeavor to lay the emotions here involved to rest, the Court will treat the claims as an unfortunate lapse of judgment not requiring a penalty award of attorney's fees to defendant.

The Second Circuit has stated (Pratt, J.), in a case also filled with sharply conflicting testimony:

> A factfinder's decision that one party's version of the events is more credible than the other party's is, without more, insufficient to justify an award of attorneys' fees to a prevailing defendant under the Copyright Act.

Roth v. Pritikin, 787 F.2d at 58.

The defendant here is amply vindicated as a professional matter by exposure of the facts.

Conclusion

Accordingly, for the reasons stated herein, plaintiff's request for injunctive relief is denied and her claims are dismissed on the merits, with costs to be taxed by the Clerk.

The foregoing shall constitute the findings of fact and conclusions of law required by Rule 52(a), Fed. R. Civ. P.

Submit judgment accordingly in conformity with Rule 54, Fed. R. Civ. P.

So Ordered.

Dated: May 3, 1988
New York, New York

/s/ MILTON POLLACK
Milton Pollack
Senior United States District Judge

Appendix C

UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

Docket Number 88-7435, 88-7465

At a stated term of the United States Court of Appeals for the Second Circuit, held at the United States Courthouse, in the City of New York, on the fourteenth day of April, one thousand nine hundred and eighty nine.

HEIDI S. WEISSMANN, M.D.,

Plaintiff-Appellant,
Cross-Appellee,

—V.—

LEONARD M. FREEMAN, M.D.,

Defendant-Appellee,
Cross-Appellant.

A petition for rehearing containing a suggestion that action be reheard in banc having been filed herein by Appellee-Cross-Appellant Leonard M. Freeman, M.D.

Upon consideration by the panel that heard the appeal, it is

Ordered that said petition for rehearing is DENIED.

It is further noted that the suggestion for rehearing in banc has been transmitted to the judges of the court in regular active service and to any other judge that heard the appeal and that no such judge has requested that a vote be taken thereon.

/s/ ELAINE B. GOLDSMITH
Elaine B. Goldsmith
Clerk